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8 Attorneys for Defendant
 NEXTDOOR.COM, INC.

10 UNITED STATES DISTRICT COURT
 11 NORTHERN DISTRICT OF CALIFORNIA
 12 SAN JOSE DIVISION

13 FATDOOR, INC. and RAJ ABHYANKER,

14 Plaintiffs,

15 v.

16 NEXTDOOR.COM, INC.,

17 Defendant.

Case No. 5:14-cv-02335-BLF

**DEFENDANT NEXTDOOR.COM, INC.'S
 ANSWER AND COUNTERCLAIMS TO
 FIRST AMENDED COMPLAINT
 (DKT. 35)**

JURY TRIAL DEMANDED

Date Action Filed: May 20, 2014

19 Defendant Nextdoor.com, Inc., by and through its undersigned counsel, answers the first
 20 amended complaint of Plaintiff Fatdoor, Inc. (Dkt. 35) (the "FAC") as follows:

21 **PARTIES, JURISDICTION, AND VENUE**

22 1. Defendant lacks knowledge or information sufficient to form a belief as to the
 23 truth or falsity of the allegations of paragraph 1 of the FAC and therefore denies them.

24 2. Defendant lacks knowledge or information sufficient to form a belief as to the
 25 truth or falsity of the allegations of paragraph 2 of the FAC and therefore denies them.

26 3. Defendant lacks knowledge or information sufficient to form a belief as to the
 27 truth or falsity of the allegations of paragraph 3 of the FAC and therefore denies them.

28 4. Defendant lacks knowledge or information sufficient to form a belief as to the

1 truth or falsity of the allegations of paragraph 4 of the FAC and therefore denies them.

2 5. Defendant admits that U.S. Patent Nos. 8,775,328, 8,732,091, and 8,738,545 have
3 improperly issued and are asserted in the FAC. Defendant lacks knowledge or information
4 sufficient to form a belief as to the truth or falsity of the remaining allegations of paragraph 5 of
5 the FAC and therefore denies them.

6 6. Defendant lacks knowledge or information sufficient to form a belief as to the
7 truth or falsity of the allegations of paragraph 6 of the FAC and therefore denies them.

8 7. Defendant admits the allegations of paragraph 7 of the FAC.

9 8. Defendant admits that Plaintiffs purport to allege a claim of patent infringement
10 arising under the Patent Act, 35 U.S.C. § 1 *et seq.* Defendant admits that the Court has subject
11 matter jurisdiction over patent infringement actions pursuant to 28 U.S.C. §§ 1331 and 1338(a).
12 Defendant lacks information sufficient to form a belief as to the truth or falsity of the remaining
13 allegations of paragraph 8 of the FAC and therefore denies them.

14 9. Defendant admits that personal jurisdiction and venue are proper in this district.
15 Defendant denies the remaining allegations of paragraph 9 of the FAC.

16 INTRADISTRICT ASSIGNMENT

17 10. Defendant admits the allegations of paragraph 10 of the FAC.

18 THE '328 PATENT

19 11. Defendant admits that Exhibit A to the FAC on its face appears to be United States
20 Patent No. 8,775,328 (the "'328 patent"), which bears the title "GEO-SPATIALLY
21 CONSTRAINED PRIVATE NEIGHBORHOOD SOCIAL NETWORK," and identifies an
22 issuance date of July 8, 2014. Defendant denies that Fatdoor is the "full owner of interest" in the
23 '328 patent and that the patent was duly issued. Defendant lacks knowledge or information
24 sufficient to form a belief as to the truth or falsity of the remaining allegations of paragraph 11 of
25 the FAC and therefore denies them.

26 12. Defendant admits that, on its face, Claim 14 of the '328 patent includes the
27 limitation "wherein the online neighborhood social network has a domain name of nextdoor
28 having a generic top-top [*sic*] level suffix of com," which was added to the patent by Mr.

1 Abhyanker long after launch of defendant Nextdoor.com's website in a transparent attempt to
2 claim that he invented in 2013 the website launched by Nextdoor.com in 2011. Defendant denies
3 the remaining allegations of paragraph 12 of the FAC.

4 13. Defendant admits that, in his Notice of Allowance, Examiner Feeney erroneously
5 agreed with Raj Abhyanker's remarks regarding the incorporation of matter from the '194
6 application into the '328 application. Defendant denies the remaining allegations of paragraph 13
7 of the FAC.

8 14. Defendant admits that Exhibit B on its face purports to be United States
9 Application No. 11/603,442 (the "'442 application) and that the '442 application was published
10 on September 20, 2007.

11 15. Defendant admits that the '442 application bears the title "MAP BASED
12 NEIGHBORHOOD SEARCH AND COMMUNITY CONTRIBUTION."

13 16. Defendant admits that U.S. Patent Application No. 11/603,442, which is owned by
14 Google, references the domain name nextdoor.com.

15 17. Defendant admits that Raj Vasant Abhyanker is the inventor listed on the '442
16 application.

17 18. Defendant lacks information sufficient to form a belief as to the truth or falsity of
18 the allegations of paragraph 18 of the FAC and therefore denies them.

19 19. Defendant lacks information sufficient to form a belief as to the truth or falsity of
20 the allegations of paragraph 19 of the FAC and therefore denies them.

21 20. Defendant lacks information sufficient to form a belief as to the truth or falsity of
22 the allegations of paragraph 20 of the FAC and therefore denies them.

23 21. Defendant lacks information sufficient to form a belief as to the truth or falsity of
24 the allegations of paragraph 21 of the FAC and therefore denies them.

25 22. Defendant lacks information sufficient to form a belief as to the truth or falsity of
26 the allegations of paragraph 22 of the FAC and therefore denies them.

27 23. Defendant denies the allegations of paragraph 23 of the FAC.

28 24. Defendant admits that, during prosecution, Examiner Feeney erroneously stated:

1 “Applicant and the Examiner discussed the claims and support in the prior applications & agreed
2 that the claimed subject matter is also supported in the parent applications.” Defendant lacks
3 information sufficient to form a belief as to the truth or falsity of the remaining allegations of
4 paragraph 24 of the FAC and therefore denies them.

5 25. Defendant admits that, during prosecution, Examiner Feeney erroneously stated:
6 “The Examiner agrees with Applicant’s remarks regarding the incorporation of the matter from
7 parent application 11/653,194, which is a continuation in part of application 11 /603,442 is proper
8 and does not add any new matter to the instant application.” Defendant lacks information
9 sufficient to form a belief as to the truth or falsity of the remaining allegations of paragraph 25 of
10 the FAC and therefore denies them.

11 26. Defendant admits that the ’328 patent purports to be a continuation-in-part of the
12 ’194 application. Defendant denies the remaining allegations of paragraph 26 of the FAC.

13 27. Defendant lacks information sufficient to form a belief as to the truth or falsity of
14 the remaining allegations of paragraph 27 of the FAC and therefore denies them.

15 28. Defendant lacks information sufficient to form a belief as to the truth or falsity of
16 the remaining allegations of paragraph 28 of the FAC and therefore denies them.

17 29. Defendant admits that, on its face, the ’328 patent does not include a terminal
18 disclaimer. Defendant denies the remaining allegations of paragraph 29 of the FAC.

19 30. Defendant denies the allegations of paragraph 30 of the FAC.

20 THE ’091 PATENT

21 31. Defendant admits that Exhibit C to the FAC on its face appears to be United States
22 Patent No. 8,732,091 (the “’091 patent”), which bears the title “SECURITY IN A GEO-
23 SPATIAL ENVIRONMENT,” and identifies an issuance date of May 20, 2014. Defendant
24 denies that Plaintiff Fatdoor is the full owner of interest in the ’091 patent and that the patent was
25 duly issued. Defendant lacks knowledge or information sufficient to form a belief as to the truth
26 or falsity of the remaining allegations of paragraph 31 of the FAC and therefore denies them.

27 THE ’545 PATENT

28 32. Defendant admits that Exhibit D to the FAC on its face appears to be United States

1 Patent No. 8,738,545 (the “’545 patent”), which bears the title “MAP BASED
2 NEIGHBORHOOD SEARCH AND COMMUNITY CONTRIBUTION,” and identifies an
3 issuance date of May 27, 2014. Defendant denies that Plaintiff Fatdoor is the full owner of
4 interest in the ’545 patent and that the patent was duly issued. Defendant lacks knowledge or
5 information sufficient to form a belief as to the truth or falsity of the remaining allegations of
6 paragraph 32 of the FAC and therefore denies them.

7 **DEFENDANT’S ACTIVITIES**

8 33. Defendant admits that Exhibit E to the FAC purports to be screenshots of
9 Defendant’s demo website. Defendant denies the remaining allegations of paragraph 33 of the
10 FAC.

11 34. Defendant denies the allegations of paragraph 34 of the FAC.

12 35. Defendant denies the allegations of paragraph 35 of the FAC.

13 36. Defendant admits that Raj Abhyanker (“Abhyanker”), purportedly acting on behalf
14 of Fatdoor, contacted Defendant on May 27, 2014 and on July 8, 2014, and that these
15 communications are reproduced in Exhibits G and H, respectively. Defendant denies that these
16 requests have gone largely ignored, as Defendant has offered to permit Abhyanker and Fatdoor to
17 withdraw their claims without Defendant seeking sanctions or attorneys’ fees owed to Defendant
18 for Abhyanker’s litigation misconduct, including bringing unsupported claims in bad faith,
19 tampering of evidence submitted to the Court and making false statements to the Court.
20 Defendant further denies that Fatdoor and/or Abhyanker own the patents that Fatdoor purports to
21 offer to license because to the extent that any valid patent rights exist, Fatdoor and Abhyanker are
22 not entitled to ownership rights in those patents. Defendant denies the remaining allegations of
23 paragraph 36 of the FAC.

24 37. Defendant denies the allegations of paragraph 37 of the FAC.

25 **CAUSE OF ACTION (WILLFUL INFRINGEMENT OF ’328 PATENT)**

26 38. Defendant incorporates and restates its responses to the allegations set forth in
27 paragraphs 1 through 37 of the FAC.

28 39. Defendant denies the allegations of paragraph 39 of the FAC.

1 40. Defendant denies the allegations of paragraph 40 of the FAC.

2 41. Defendant denies the allegations of paragraph 41 of the FAC.

3 42. Defendant denies the allegations of paragraph 42 of the FAC.

4 43. Defendant admits that Abhyanker, purportedly acting on behalf of Fatdoor,
5 contacted counsel for Nextdoor on July 8, 2014 and that this communication is reproduced in
6 Exhibit H to the FAC. Defendant admits that the '328 patent was referenced in this
7 communication. Defendant denies that this communication was in good faith, as Fatdoor and
8 Abhyanker are aware that (i) to the extent that any valid patent rights exist, Fatdoor and
9 Abhyanker have no ownership interest in them; (ii) the patents issued to Abhyanker asserted in
10 this case were obtained through inequitable conduct by Abhyanker during the prosecution of the
11 patents, thus rendering them all unenforceable; and (iii) the patents are invalid because the
12 effective priority dates for the patents are either in 2013 or 2014.

13 44. Defendant admits that in Abhyanker's communication of July 8, 2014, Abhyanker
14 requested a response by Friday, July 11, 2014 at 1 p.m.

15 45. Defendant admits that counsel to Nextdoor did not respond to Abhyanker's
16 communication of July 8, 2014 prior to the filing of the FAC. Defendant denies that Nextdoor's
17 counsel has not otherwise communicated with Abhyanker.

18 46. Defendant denies that the request has gone largely ignored, as Defendant offered
19 to permit Abhyanker and Fatdoor, subject to certain conditions, to withdraw their claims without
20 Defendant seeking sanctions or attorneys' fees owed to Defendant for Abhyanker's litigation
21 misconduct, including bringing unsupported claims in bad faith, tampering of evidence submitted
22 to the Court and making false statements to the Court. Defendant further denies that Fatdoor
23 and/or Abhyanker own the patents that Fatdoor purports to offer to license because to the extent
24 that any valid patent rights exist, Fatdoor and Abhyanker are not entitled to ownership rights in
25 those patents. Defendant denies the remaining allegations of paragraph 46 of the FAC.

26 **CAUSE OF ACTION (WILLFUL INFRINGEMENT OF '091 PATENT)**

27 47. Defendant incorporates and restates its responses to the allegations set forth in
28 paragraphs 1 through 46 of the FAC.

1 48. Defendant denies the allegations of paragraph 48 of the FAC.

2 49. Defendant denies the allegations of paragraph 49 of the FAC.

3 50. Defendant denies the allegations of paragraph 50 of the FAC.

4 51. Defendant denies the allegations of paragraph 51 of the FAC.

5 52. Defendant admits that Abhyanker, purportedly acting on behalf of Fatdoor,
6 contacted counsel for Nextdoor on May 27, 2014 and that this communication is reproduced in
7 Exhibit G to the FAC. Defendant admits that the '091 patent was referenced in this
8 communication. Defendant denies that this communication was in good faith, as Fatdoor and
9 Abhyanker are aware that (i) to the extent that any valid patent rights exist, Fatdoor and
10 Abhyanker have no ownership interest in them; (ii) the patents issued to Abhyanker asserted in
11 this case were obtained through inequitable conduct by Abhyanker during the prosecution of the
12 patents, thus rendering them all unenforceable; and (iii) the patents are invalid because the
13 effective priority dates for the patents are either in 2013 or 2014.

14 53. Defendant denies the allegations in paragraph 53 of the FAC.

15 54. Defendant admits that neither executives of Nextdoor nor counsel to Nextdoor
16 responded to Abhyanker's communication of May 27, 2014 by June 8, 2014.

17 55. Defendant denies that Plaintiff's requests have gone largely ignored, as Defendant
18 has offered to permit Abhyanker and Fatdoor, subject to certain conditions, to withdraw their
19 claims without Defendant seeking sanctions or attorneys' fees owed to Defendant for
20 Abhyanker's litigation misconduct, including bringing unsupported claims in bad faith, tampering
21 of evidence submitted to the Court and making false statements to the Court. Defendant further
22 denies that Fatdoor and/or Abhyanker own the patents that Fatdoor purports to offer to license
23 because to the extent that any valid patent rights exist, Fatdoor and Abhyanker are not entitled to
24 ownership rights in those patents. Defendant denies the remaining allegations of paragraph 55 of
25 the FAC.

26 **CAUSE OF ACTION (WILLFUL INFRINGEMENT OF '545 PATENT)**

27 56. Defendant incorporates and restates its responses to the allegations set forth in
28 paragraphs 1 through 55 of the FAC.

57. Defendant denies the allegations of paragraph 57 of the FAC.

58. Defendant denies the allegations of paragraph 58 of the FAC.

59. Defendant denies the allegations of paragraph 59 of the FAC.

60. Defendant denies the allegations of paragraph 60 of the FAC.

61. Defendant admits that Raj Abhyanker, purportedly acting on behalf of Fatdoor, contacted counsel for Nextdoor on May 27, 2014 and that this communication is reproduced in Exhibit G to the FAC. Defendant admits that the '545 patent was referenced in this communication. Defendant denies that this communication was in good faith, as Fatdoor and Abhyanker are aware that (i) to the extent that any valid patent rights exist, Fatdoor and Abhyanker have no ownership interest in them; (ii) the patents issued to Abhyanker asserted in this case were obtained through inequitable conduct by Abhyanker during the prosecution of the patents, thus rendering them all unenforceable; and (iii) the patents are invalid because the effective priority dates for the patents are either in 2013 or 2014.

62. Defendant denies the allegations in paragraph 62 of the FAC.

63. Defendant admits that neither executives of Nextdoor nor counsel to Nextdoor responded to Abhyanker's communication of May 27, 2014 by June 8, 2014.

64. Defendant denies that Plaintiff's requests have gone largely ignored, as Defendant has offered to permit Abhyanker and Fatdoor, subject to certain conditions, to withdraw their claims without Defendant seeking sanctions or attorneys' fees owed to Defendant for Abhyanker's litigation misconduct, including bringing unsupported claims in bad faith, tampering of evidence submitted to the Court and making false statements to the Court. Defendant further denies that Fatdoor and/or Abhyanker own the patents that Fatdoor purports to offer to license because to the extent that any valid patent rights exist, Fatdoor and Abhyanker are not entitled to ownership rights in those patents. Defendant denies the remaining allegations of paragraph 64 of the FAC.

REQUEST FOR RELIEF

65. Defendant denies that Plaintiff is entitled to any of the relief requested in the FAC. Defendant denies all averments in the FAC that have not been specifically admitted in paragraphs

1-64 above.

DEMAND FOR JURY TRIAL

66. Plaintiff's demand for a jury trial does not require a response.

ADDITIONAL DEFENSES

67. Defendant asserts the following additional defenses to the complaint. In doing so, Defendant does not assume any burden of proof on any issue that is Plaintiff's burden as a matter of law. Defendant also reserves the right to amend or supplement these defenses as additional facts become known.

FIRST DEFENSE: FAILURE TO STATE A CAUSE OF ACTION

68. The complaint fails to state a cause of action against Defendant for which relief can be granted.

SECOND DEFENSE: NON-INFRINGEMENT ('328 PATENT)

69. Defendant has not infringed, and currently does not infringe, any valid claim of the '328 patent and is not liable for any infringement.

THIRD DEFENSE: INVALIDITY ('328 PATENT)

70. The '328 patent is invalid for failure to meet one or more of the conditions for patentability specified in Title 35, U.S.C., or the rules, regulations, and law related thereto, including, without limitation, one or more of 35 U.S.C. §§ 101, 102, 103, and/or 112.

FOURTH DEFENSE: NON-INFRINGEMENT ('091 PATENT)

71. Defendant has not infringed, and currently does not infringe, any valid claim of the '091 patent and is not liable for any infringement.

FIFTH DEFENSE: INVALIDITY ('091 PATENT)

72. The '091 patent is invalid for failure to meet one or more of the conditions for patentability specified in Title 35, U.S.C., or the rules, regulations, and law related thereto, including, without limitation, one or more of 35 U.S.C. §§ 101, 102, 103, and/or 112.

SIXTH DEFENSE: NON-INFRINGEMENT ('545 PATENT)

73. Defendant has not infringed, and currently does not infringe, any valid claim of the '545 patent and is not liable for any infringement.

SEVENTH DEFENSE: INVALIDITY ('545 PATENT)

74. The '545 patent is invalid for failure to meet one or more of the conditions for patentability specified in Title 35, U.S.C., or the rules, regulations, and law related thereto, including, without limitation, one or more of 35 U.S.C. §§ 101, 102, 103, and/or 112.

EIGHTH DEFENSE: ESTOPPEL

75. The relief sought by Plaintiff is barred, in whole or in part, under the doctrine of prosecution history estoppel due to Plaintiff's (or Plaintiff's predecessor-in-interest's) prior conduct, including the amendment, cancellation, or abandonment of claims before the United States Patent and Trademark Office and/or admissions or other statements made to the United States Patent and Trademark Office during prosecution of the '328 patent, the '091 patent, the '545 patent, or related patent applications.

NINTH DEFENSE: DEDICATION TO THE PUBLIC

76. The relief sought by Plaintiff is barred, in whole or in part, because Plaintiff dedicated to the public all methods, systems, and products disclosed in the '328 patent, the '091 patent, and/or the '545 patent but not literally claimed therein.

TENTH DEFENSE: LACK OF STANDING

77. Plaintiff lacks standing to assert infringement of the '328 patent, the '091 patent, and/or the '545 patent because it did not have sufficient rights in the '328 patent, the '091 patent, and/or the '545 patent at the time the suit was filed.

ELEVENTH DEFENSE: LACK OF OWNERSHIP

78. Plaintiff is barred from obtaining all, or part of, the relief it seeks because it lacks sufficient ownership interests in the '328 patent, the '091 patent, and/or the '545 patent to pursue claims of infringement against Defendant.

TWELFTH DEFENSE: UNAVAILABILITY OF INJUNCTIVE RELIEF

79. Plaintiff is not entitled to injunctive relief, as a matter of law, and cannot satisfy the requirements applicable to its request for injunctive relief in any form.

THIRTEENTH DEFENSE: INEQUITABLE CONDUCT ('091 PATENT)**Introduction**

80. The '091 patent, and each claim thereof, is unenforceable due to inequitable conduct during its prosecution.

81. During prosecution of the '091 patent, Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized information that he knew would have been important to a reasonable examiner in determining whether to issue the patent.

82. Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized this material information with a specific intent to deceive the United States Patent and Trademark Office ("USPTO").

83. Abhyanker filed U.S. Patent Application No. 14/151,844 (the "'844 application") on January 10, 2014. The '844 application issued as the '091 patent.

84. Abhyanker, the named inventor of the '844 application, served as patent prosecution counsel for the '844 application.

85. Abhyanker's USPTO registration number, submitted with his filings in the '844 application, is Reg. No. 45474.

Improper Claims of Priority

86. Upon information and belief, Abhyanker, as a licensed patent attorney, is familiar with the rules governing the patent process.

87. Specifically, upon information and belief, Abhyanker knew at the time he filed the '844 application that in order to claim the benefit of an earlier application's priority date, 1) the invention disclosed in the earlier application must support the claims of the later application, and 2) the two applications must have been co-pending.

88. The USPTO issued and mailed a non-final rejection on March 17, 2014, rejecting all pending claims of the '844 application in light of Kaplan, Dan, "Fatdoor turns neighborhoods into online social networks," May 28, 2007 ("Kaplan").

89. Kaplan described the public use and sale of Fatdoor services offered by a previous company called Fatdoor, Inc. ("Fatdoor I") which Raj Abhyanker, the CEO of the later entity,

1 Plaintiff Fatdoor, Inc. also served as CEO.

2 90. Upon information and belief, Abhyanker and therefore Plaintiff Fatdoor, Inc. knew
3 that Fatdoor I offered services similar to those claimed in the pending claims of the '844
4 application.

5 91. The USPTO rejected independent claim 1 of the '844 application as anticipated by
6 Kaplan because it “discloses a neighborhood communication system: a privacy server: to verify
7 that each user of the community network lives at a residence associated with a claimable
8 residential address of the community network formed through a social community module of a
9 privacy server using a processor and a memory; to obtain from each user of the community
10 network, using the processor of a computing device, member data associated with each user, the
11 member data including an address; to associate the address with a profile of each user; to
12 determine a location of each user based on the member data; to store the member data in a
13 database; and to obtain a personal address privacy preference from each user, the personal address
14 privacy preference specifying if the address should be displayed to other users; and a mapping
15 server associated with the privacy server through a network to generate a geospatial
16 representation of a set of points on a map defining residences associated with each use of the
17 community network having the member data.”

18 92. The USPTO rejected independent claim 13 of the '844 application as anticipated
19 by Kaplan because it “discloses [a] method of organizing a community network, comprising:
20 verifying that each user of the community network lives at a residence associated with a
21 claimable residential address of the community network formed through a social community
22 module of a privacy server using a processor and a memory; obtaining from each user of the
23 community network, using the processor of a computing device, member data associated with
24 each user, the member data including an address; associating the address with a profile of each
25 user; determining a location of each user based on the member data; storing the member data in a
26 database; and obtaining a personal address privacy preference from each user, the personal
27 address privacy preference specifying if the address should be displayed to other users.”

28 93. The USPTO rejected independent claim 25 of the '844 application as anticipated

1 by Kaplan because it “discloses a neighborhood communication system comprising: a privacy
2 server: to verify that each user of the community network lives at a residence associated with a
3 claimable residential address of the community network formed through a social community
4 module of a privacy server using a processor and a memory; to obtain from each user of the
5 community network, using the processor of a computing device, member data associated with
6 each user, the member data including an address; to associate the address with a profile of each
7 user; to determine a location of each user based on the member data; to store the member data in a
8 database; and to obtain a personal address privacy preference from each user, the personal address
9 privacy preference specifying if the address should be displayed to other users; a network; and a
10 mapping server associated with the privacy server through a network: to generate a geospatial
11 representation of a set of points on a map defining residences associated with each use of the
12 community network having the member data, determine that a marker is colliding with another
13 marker simultaneously displayed in a map based on an overlap area of the marker with the
14 another marker, automatically create a group pointer that replaces the marker and the another
15 marker on the map, generate a view of the marker and the another marker when a user selects the
16 group pointer, and determine that the marker, the another marker, and different markers are
17 associated with a shared structure based on address data associated with occupants represented
18 through the marker, the another marker and the different markers.”

19 94. Abhyanker submitted a Response to Non-Final Office Action on March 26, 2014
20 (the “Response”).

21 95. In the Response, Abhyanker contested the USPTO’s determination that Kaplan
22 anticipated the pending claims of the ’844 application.

23 96. Abhyanker represented to the USPTO that Kaplan was disqualified as prior art on
24 the ground that the ’844 application was entitled to a priority date of March 17, 2006.

25 97. Abhyanker represented to the USPTO that the pending claims of the ’844
26 application were entitled to claim priority to U.S. Patent Application 11/653,194 (the “’194
27 application”), filed on January 12, 2007, which in turned claimed priority to U.S. Patent
28 Application No. 11/603,442 (the “’442 application”), filed on November 22, 2006.

1 98. The '442 application claims priority to U.S. Provisional Application 60/783,226,
2 filed on March 17, 2006.

3 99. Abhyanker's claims for priority in the '844 application to the '442 and '194
4 applications are improper. For example, a pending claim is entitled to the benefit of the filing
5 date of an earlier-filed application only if that earlier-filed application discloses each and every
6 element of the pending claim.

7 100. As such, by representing to the USPTO that the pending claims of the '844
8 application were entitled to the filing dates of the '194 and '442 applications, Abhyanker in effect
9 represented that the specifications of the '194 and '442 applications each fully disclosed the
10 subject matter of the pending claims of the '844 application.

11 101. This representation by Abhyanker to the USPTO as to the '194 application was
12 incorrect. None of the pending '844 claims was supported by the '194 application.

13 102. By way of example, the concept of a "privacy preference," a central feature of all
14 claims of the '844 application, is found nowhere in the disclosures of the '194 application.

15 103. Similarly, Abhyanker's representation to the USPTO as to the '442 application
16 was incorrect. None of the pending claims in the '844 application was supported by the '442
17 application

18 104. By way of example, the concept of a "privacy preference," a central feature of all
19 claims of the '844 application, is found nowhere in the disclosures of the '442 application.

20 105. On information and belief, Abhyanker intentionally made these representations,
21 knowing them to be incorrect, in order to mislead the USPTO as to the content of the '442 and
22 '194 applications.

23 106. Abhyanker is the sole inventor listed on the '442 and '194 applications, filed in
24 2006 and 2007 respectively. Abhyanker thus is familiar with the subject matter disclosed in those
25 applications.

26 107. Given his status the sole inventor of the '442 and '194 applications, Abhyanker
27 knew that those applications did not fully support the pending claims of the '844 application,
28 including without limitation that those applications did not disclose a "privacy preference."

1 108. Additionally, the '844 application fails to meet the co-pendency requirement at
2 least with respect to the '442 application. The '442 application was abandoned on June 24, 2009.
3 Abhyanker later filed the '844 application on January 10, 2014, identifying the '844 application
4 as a continuation-in-part of the '442 application.

5 109. Thus, the '844 application and '442 application were not co-pending.

6 110. Upon information and belief, Abhyanker recognized after he filed the '844
7 application that co-pendency was lacking.

8 111. On January 21, 2014—over four years after the '442 application was abandoned
9 and eleven days after filing the '844 application—Abhyanker filed a request for continued
10 examination of the '442 application in a sham effort to establish co-pendency.

11 112. However, because the '442 application was abandoned at the time Abhyanker filed
12 the '844 application, the '844 application was not co-pending with the '442 application.

13 113. Upon information and belief, Abhyanker knew that the '442 application and '194
14 application disclosures did not support any of the pending claims of the '844 application and that
15 co-pendency was lacking at least between the '091 patent application and the '442 application.

16 114. Abhyanker's misrepresentations concerning the co-pendency of the '442
17 application and the entitlement of the '844 application to the priority dates of the '194 and '442
18 applications were material, as evidenced at least by the USPTO's rejection of the pending claims
19 of the '844 application in light of Kaplan and the USPTO's withdrawal its rejection in response to
20 Abhyanker's misrepresentations concerning the '194 and '442 applications.

21 115. Absent these misrepresentations, the USPTO would not have disqualified Kaplan
22 as prior art.

23 116. Moreover, upon information and belief, Abhyanker knew that his improper claims
24 of priority to the '442 and '194 applications were material to the patentability of the pending
25 claims of the '844 application.

26 117. Abhyanker exhibited as much during the prosecution of the '844 application. As
27 noted above, in his Response, Abhyanker argued that Kaplan should be disqualified because the
28 pending claims of the '844 application were entitled to claim the benefit of the '194 and '442

1 applications.

2 118. Upon further information and belief, Abhyanker had the specific intent of claiming
3 priority to the '442 and '194 applications in an attempt to deceive the USPTO and avoid prior art,
4 such as the public use of the Fatdoor services by Fatdoor I, that a reasonable examiner would rely
5 upon to reject the pending claims of the '844 application. Those claims, now issued as the '091
6 patent, would stand rejected but for Abhyanker's improper claims of priority to the '194 and '442
7 applications.

8 119. Abhyanker's claims of priority in the '844 application misrepresented information
9 material to patentability.

10 120. Upon information and belief, Abhyanker specifically intended to deceive the
11 USPTO as to whether the pending claims of the '844 application were entitled to the priority date
12 of either the '194 application or '442 application.

13 **Misrepresentation Regarding AIA Rules**

14 121. In addition to his material misrepresentation of the '091 patent's priority date,
15 Abhyanker omitted material information when, during the '844 application's prosecution, he did
16 not indicate to the USPTO that the '091 patent application should be examined under the first-to-
17 file provisions of the America Invents Act ("AIA") because it has at least one claim with an
18 effective filing date after March 16, 2013.

19 122. Upon information and belief, Abhyanker, a licensed patent attorney, knew that the
20 '844 application, a continuation-in-part filed in 2014, had at least one claim with an effective date
21 after March 16, 2013.

22 123. Nevertheless, Abhyanker did not check the box provided on a USPTO form to
23 indicate that the '844 application should be examined under AIA rules, upon information and
24 belief, with the specific intent of deceiving the USPTO and avoiding prior art, such as the public
25 use of Fatdoor services.

26 124. Had Abhyanker properly indicated that the '844 application should be examined
27 according to the AIA, one or more claims would have been accorded the January 10, 2014 '844
28 application filing date, and the USPTO would have rejected those claims in view of Kaplan.

125. Abhyanker's contention that the '844 application should be examined according to pre-AIA rules misrepresented information material to patentability.

126. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to whether the pending claims of the '844 application were entitled to be examined under pre-AIA rules.

Failure to Disclose References Relied on by the USPTO During Prosecution of Another Patent Application

127. During prosecution of the '844 application, Abhyanker contended that the '844 application was entitled to the benefit of the '194 application's priority date.

128. This contention was an effort to support his improper priority claims.

129. Accordingly, and by Abhyanker's own representation, the '194 application discloses similar subject matter to that claimed by the '844 application.

130. Abhyanker did not disclose the following references to the USPTO during the prosecution of the '844 application: Publication No. US-2001/0005829 by Raveis ("Raveis"); Publication No. US-2006/0022048 by Johnson ("Johnson"); and Publication No. US-2007/1056429 by Godar ("Godar").

131. The USPTO cited Raveis in support of a non-final rejection of the '194 application issued on May 10, 2011.

132. The USPTO cited Johnson in support of a final rejection of the '194 application issued on December 10, 2012.

133. The USPTO cited Godar in support of a non-final rejection of the '194 application issued on January 28, 2014.

134. That the USPTO cited these references in support of its rejection of the '194 application, particularly in view of Abhyanker's argument of this application's relevance to the '844 application's claims, confirms that the USPTO would have considered them prior art material to the patentability of the '844 application.

135. Upon information and belief, and in view of Abhyanker's knowledge that his claims of priority were improper (as well his contemporaneous knowledge of the USPTO's

1 rejection of such a priority date in connection with the '612 application that led to the '545 patent,
2 as explained below), Abhyanker knew that the USPTO would have considered these references to
3 be prior art material to the patentability of the '844 application.

4 136. Abhyanker nonetheless did not disclose Raevis, Johnson, or Godar during
5 prosecution of the '844 application even though he knew that the USPTO would have considered
6 them to be prior art material to patentability.

7 137. Upon information and belief, Abhyanker specifically intended to deceive the
8 USPTO as to the existence of material prior art such as Raevis, Johnson, and Godar.

9 **Failure to Disclose References Identified by the USPTO During Prosecution of Another**
10 **Patent Application**

11 138. Abhyanker also did not disclose the following references to the USPTO during the
12 prosecution of the '844 application: Publication No. US-2004/0039581 by Wheeler ("Wheeler");
13 Publication No. US-2006/0190279 by Heflin ("Heflin"); Publication No. US-2003/022807 by
14 Hoffman ("Hoffman"); and Publication No. US-2005/0203768 by Florance ("Florance").

15 139. In a non-final rejection of the '194 application issued on January 28, 2014, the
16 USPTO notified Abhyanker that it considered all of these references relevant to the '194
17 application even though it had not specifically outlined their application under 35 U.S.C. §§ 102
18 or 103. The USPTO advised Abhyanker to review these references in particular.

19 140. That the USPTO identified these references as relevant in support of its rejection
20 of the '194 application, particularly in view of Abhyanker's arguments that the '194 application
21 fully discloses the invention(s) claimed in the '844 application, confirms that the USPTO would
22 have considered it to be prior art material to the patentability of the '844 application.

23 141. Upon information and belief, and in view of Abhyanker's knowledge that his
24 claims of priority were improper (as well his contemporaneous knowledge of the USPTO's
25 rejection of such a priority date in connection with the '612 application that led to the '545 patent,
26 as explained below), Abhyanker knew that the USPTO would have considered these references to
27 be prior art material to the patentability of the '844 application.

28 142. Abhyanker nonetheless did not disclose Wheeler, Heflin, Hoffman, or Florance

1 during prosecution of the '844 application even though he knew that the USPTO would have
2 considered them to be prior art material to patentability.

3 143. Upon information and belief, Abhyanker specifically intended to deceive the
4 USPTO as to the existence of material prior art such as Wheeler, Heflin, Hoffman, and Florance.

5 **Failure to Disclose Nextdoor.com Website**

6 144. Abhyanker also did not disclose the existence of Defendant's website,
7 Nextdoor.com, and services and features provided therein, in an information disclosure statement
8 during prosecution of the '844 application.

9 145. Nextdoor.com launched to the general public in October 2011, although it had
10 been in public beta testing since early 2011.

11 146. Given that Abhyanker has, on the day of issuance, accused the Nextdoor.com
12 website of infringing the '091 patent, Abhyanker knew that the USPTO would have considered
13 the Nextdoor.com website material to patentability.

14 147. Upon information and belief, and in view of Abhyanker's knowledge that his
15 claims of priority were improper, as well his contemporaneous knowledge of the USPTO's
16 rejection of such a priority date in connection with the '612 application that led to the '545 patent,
17 as explained below, Abhyanker knew that the USPTO would have considered Nextdoor.com to
18 be prior art material to the patentability of the '844 application.

19 148. Abhyanker nonetheless did not disclose the Nextdoor.com website during
20 prosecution of the '844 application even though he knew that the USPTO would have considered
21 it to be prior art material to patentability.

22 149. Upon information and belief, Abhyanker specifically intended to deceive the
23 USPTO as to the existence of material prior art such as the Nextdoor.com website.

24 **Conclusion**

25 150. In sum, on information and belief, Abhyanker, the inventor and patent attorney for
26 the '091 patent, misrepresented and omitted material information with the intent to deceive the
27 USPTO to ensure the issuance of the '091 patent.

28 151. By reason of this inequitable conduct, the '091 patent and all related patents are

unenforceable.

152. The '091 patent is further unenforceable as a result of Abhyanker's inequitable conduct committed during the prosecution of related patent applications, including without limitation U.S. Patent Application No. 14/203,531, addressed below, and U.S. Patent Application No. 14/144,612, addressed below.

FOURTEENTH DEFENSE: INEQUITABLE CONDUCT ('545 PATENT)

Introduction

153. The '545 patent, and each claim thereof, is unenforceable due to inequitable conduct during its prosecution.

154. During prosecution of the '545 patent, Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized information that he knew would have been important to a reasonable examiner in determining whether to issue the patent.

155. Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized this material information with a specific intent to deceive the United States Patent and Trademark Office ("USPTO").

156. Abhyanker filed U.S. Patent Application No. 14/144,612 (the "'612 application") on December 31, 2013. The '612 application issued as the '545 patent.

157. Abhyanker, the named inventor of the '612 application, served as patent prosecution counsel for the '612 application.

158. Abhyanker's USPTO registration number, submitted with his filings in the '612 application, is Reg. No. 45474.

Improper Claims of Priority

159. Upon information and belief, Abhyanker, as a licensed patent attorney, is familiar with the rules governing the patent process.

160. Specifically, upon information and belief, Abhyanker knew at the time he filed the '612 application that in order to claim the benefit of an earlier application's priority date, 1) the invention disclosed in the earlier application must support the claims of the later application, and 2) the two applications must have been co-pending.

1 161. The USPTO issued and mailed a non-final rejection on March 6, 2014, rejecting
2 all pending claims of the '612 application.

3 162. The USPTO's rejection stood in part on the ground that Abhyanker's priority
4 claims were improper and that, instead, the claims of the '612 application were entitled to an
5 effective filing date of December 31, 2013.

6 163. The USPTO further based its rejection under 35 U.S.C. 103(a), finding that the
7 claims of the '612 application were unpatentable over Abhyanker's own '442 application and
8 U.S. Patent Application No. 11/717,807 (the "'087 application), filed in 2006 and 2007,
9 respectively.

10 164. Abhyanker submitted a response to the non-final office action on March 10, 2014
11 (the "'612 Response").

12 165. In the '612 Response, Abhyanker contested the USPTO's determination that the
13 claims of the '612 application were entitled to an effective filing date of December 31, 2013.

14 166. Abhyanker represented to the USPTO that the pending claims of the '612
15 application were entitled to claim priority to the '194 application, filed on January 12, 2007,
16 which in turned claimed priority to the '442, filed on November 22, 2006.

17 167. The '442 application claims priority to U.S. Provisional Application 60/783,226,
18 filed on March 17, 2006.

19 168. Abhyanker's claims for priority in the '844 application to the '442 and '194
20 applications are improper. For example, a pending claim is entitled to the benefit of the filing
21 date of an earlier-filed application only if that earlier-filed application discloses each and every
22 element of the pending claim.

23 169. In the Response, Abhyanker specifically represented that the pending claims of the
24 '612 application were "entirely supported" in the specification of the '194 application, as well as
25 by the specifications of two other patent applications, Nos. 11/731,465 (the "'465 application")
26 and 11/827,400 (the "'400 application").

27 170. This representation by Abhyanker to the USPTO as to the '194, '465, and '400
28 applications was incorrect. None of the pending claims of the '612 application was supported by

1 these applications.

2 171. By way of example, the concept of conducting “high value crime and safety
3 related discussions,” which is central to all claims of the ’612 application, is found nowhere in the
4 disclosures of the ’194, ’465, or ’400 applications.

5 172. On information and belief, Abhyanker, a licensed patent attorney, intentionally
6 made these representations, knowing them to be incorrect, in order to mislead the USPTO as to
7 the content of the ’194, ’465, and ’400 applications.

8 173. Abhyanker is the sole inventor listed on the ’194, ’465, and ’400 applications, all
9 filed in 2007. Abhyanker thus is familiar with the subject matter disclosed in those applications.

10 174. Given his status as the sole inventor of the ’194, ’465, and ’400 applications,
11 Abhyanker knew that those applications did not fully support the pending claims of the ’612
12 application, including without limitation that those applications did not disclose the concept of
13 conducting “high value crime and safety related discussions.”

14 175. Additionally, the ’612 application fails to meet the co-pendency requirement at
15 least with respect to the ’442 application. The ’442 application was abandoned on June 24, 2009.
16 Abhyanker later filed the ’612 application on December 31, 2013.

17 176. Thus, the ’612 application and ’442 application were not co-pending.

18 177. Upon information and belief, Abhyanker recognized after he filed the ’612
19 application that co-pendency was lacking.

20 178. On January 21, 2014—over four years after the ’442 application was abandoned
21 and twenty-one days after filing the ’612 application—Abhyanker filed a request for continued
22 examination of the ’442 application in a sham effort to establish co-pendency.

23 179. However, because the ’442 application was abandoned at the time Abhyanker filed
24 the ’612 application, the ’612 application was not co-pending with the ’442 application.

25 180. Upon information and belief, Abhyanker knew that the ’442 application and ’194
26 application disclosures did not support any of the pending claims of the ’612 application and that
27 co-pendency was lacking at least between the ’612 patent application and the ’442 application.

28 181. Abhyanker nonetheless represented in the Response of March 10, 2014 that the

1 '612 application was entitled to the benefit of the '442 application's priority date.

2 **Failure to Disclose Kaplan Reference Relied on by the USPTO or Other Fatdoor References**
3 **During the Prosecution of Another Application**

4 182. Abhyanker also did not disclose the following reference to the USPTO during the
5 prosecution of the '612 application: Kaplan, Dan, "Fatdoor turns neighborhoods into online social
6 networks," May 28, 2007 ("Kaplan").

7 183. Kaplan describes the public use and sale of Fatdoor services offered by a previous
8 company called Fatdoor, Inc. ("Fatdoor I") of which Raj Abhyanker, the CEO of the later entity,
9 Plaintiff Fatdoor, Inc. also served as CEO.

10 184. More generally, Abhyanker failed to disclose any references describing services
11 offered by Fatdoor I, including the fatdoor.com website.

12 185. Upon information and belief, Abhyanker knew that Fatdoor I offered services
13 similar to those claimed in the pending claims of the '612 application.

14 186. Abhyanker became aware of Kaplan in particular no later than March 17, 2014, at
15 which time Kaplan was cited by the USPTO during prosecution of the '844 application in
16 connection with a non-final rejection.

17 187. Abhyanker did not disclose the office action wherein the examiner cited Kaplan.

18 188. Abhyanker was personally involved in the development of Fatdoor I and was
19 aware of services made publicly available at fatdoor.com.

20 189. The '091 and '545 patents disclose and claim similar subject matter, and the '091
21 patent claims to be a continuation-in-part of the '612 application.

22 190. Accordingly, material prior art to the '844 application would also have been
23 material prior art to the '612 application.

24 191. Upon information and belief, Abhyanker knew that the USPTO would have found
25 Kaplan to be material to patentability because the USPTO had previously relied on Kaplan in
26 issuing a rejection of the '844 application.

27 192. During the prosecution of the '844 application, Abhyanker argued that Kaplan was
28 not prior art to the '844 application because the '844 application was entitled to a priority date

1 prior to Kaplan's publication date of May 28, 2007, in particular, that of the '442 application,
2 filed November 22, 2006.

3 193. During the prosecution of the '612 application, Abhyanker argued that the '612
4 patent was also entitled to the '442 application's priority date.

5 194. The USPTO rejected Abhyanker's claim of priority for the '612 application,
6 instead according its claims an effective filing date of December 31, 2013. The USPTO
7 accordingly examined the '612 application under AIA rules.

8 195. Upon information and belief, Abhyanker knew that the USPTO would have
9 considered Kaplan to be prior art to the '612 application.

10 196. Abhyanker nonetheless did not disclose Kaplan during prosecution of the '612
11 application even though he knew that the USPTO would have considered Kaplan to be prior art
12 material to patentability.

13 197. Upon information and belief, Abhyanker specifically intended to deceive the
14 USPTO as to the existence of material prior art such as Kaplan.

15 198. Upon information and belief, because Kaplan describes the operation of services
16 then available at fatdoor.com, Abhyanker knew that the USPTO would have considered
17 fatdoor.com, or any reference describing it, to be prior art to the '612 application.

18 199. Abhyanker nonetheless did not disclose fatdoor.com, or any reference describing
19 it, during prosecution of the '612 application even though he knew that the USPTO would have
20 considered them to be prior art material to patentability.

21 200. Upon information and belief, Abhyanker specifically intended to deceive the
22 USPTO as to the existence of material prior art such as fatdoor.com or any reference describing
23 it.

24 **Failure to Disclose Other References Relied on by the USPTO**
25 **During the Prosecution of the '844 Application**

26 201. The USPTO cited several other references in support of the non-final rejection of
27 the '844 application on March 17, 2014. These include U.S. Patent No. 8,650,103, by Wilf et al.
28 ("Wilf"); Publication No. US-2013/0282842, by Blecon et al. ("Blecon"); Publication No. US-

1 2011/0231268, by Ungos (“Ungos”); and an article from Wired.com entitled “Fatdoor CEO Talks
2 about balancing security with community,” by Russell (“Russell”).

3 202. That the USPTO cited these references in support of its rejection of the ’844
4 application confirms that the USPTO would have considered them prior art material to the
5 patentability of the ’612 application.

6 203. Upon information and belief, and in view of the USPTO’s conclusion that the ’612
7 application’s claims were entitled to an effective filing date of December 31, 2013, Abhyanker
8 knew that the USPTO would have considered these references to be prior art material to the
9 patentability of the ’612 application.

10 204. Abhyanker nonetheless did not disclose Wilf, Blecon, Ungos, or Russell during
11 prosecution of the ’612 application even though he knew that the USPTO would have considered
12 them to be prior art material to patentability.

13 205. Upon information and belief, Abhyanker specifically intended to deceive the
14 USPTO as to the existence of material prior art such as Wilf, Blecon, Ungos, and Russell.

15 **Failure to Disclose References Relied on by the USPTO During the**
16 **Prosecution of the ’194 and ’400 Applications**

17 206. In addition, during prosecution of the ’612 application, Abhyanker argued, in a
18 March 10, 2014 response to a March 6, 2014 non-final rejection, that the independent claims of
19 the ’612 application “are entirely supported” in the specifications of the ’194, ’465, and ’400
20 applications.

21 207. Accordingly, and by Abhyanker’s own representation, the ’194, ’465, and ’400
22 applications disclose similar subject matter to that claimed by the ’612 application.

23 208. Abhyanker did not disclose the following references to the USPTO during the
24 prosecution of the ’612 application: Publication No. US-2001/0005829 by Raveis (“Raveis”);
25 Publication No. US-2006/0022048 by Johnson (“Johnson”); Publication No. US-2007/1056429
26 by Godar (“Godar”); Publication No. 2008/0125969 by Chen (“Chen”); and Publication No.
27 2007/0203644 by Thota (“Thota”).

28 209. The USPTO cited Raevis in support of a non-final rejection of the ’194 application

1 issued on May 10, 2011.

2 210. The USPTO cited Johnson in support of a final rejection of the '194 application
3 issued on December 10, 2012.

4 211. The USPTO cited Godar in support of a non-final rejection of the '194 application
5 issued on January 28, 2014.

6 212. The USPTO cited Chen and Thota in support of a non-final rejection of the '400
7 application issued on April 12, 2011.

8 213. That the USPTO cited these references in support of its rejection of the '194 and
9 '400 applications, particularly in view of Abhyanker's argument of these applications' relevance
10 to the '612 application's claims, confirms that the USPTO would have considered them prior art
11 material to the patentability of the '612 application.

12 214. Upon information and belief, and in view of the USPTO's conclusion that the '612
13 application's claims were entitled to an effective filing date of December 31, 2013, Abhyanker
14 knew that the USPTO would have considered these references to be prior art material to the
15 patentability of the '612 application.

16 215. Abhyanker nonetheless did not disclose Raevis, Johnson, Godar, Chen, and Thota
17 during prosecution of the '612 application even though he knew that the USPTO would have
18 considered them to be prior art material to patentability.

19 216. Upon information and belief, Abhyanker specifically intended to deceive the
20 USPTO as to the existence of material prior art such as Raevis, Johnson, Godar, Chen, and Thota.

21 **Failure to Disclose References Identified by the USPTO**
22 **During the Prosecution of the '194 Application**

23 217. Abhyanker also did not disclose the following references to the USPTO during the
24 prosecution of the '612 application: Publication No. US-2004/0039581 by Wheeler ("Wheeler");
25 Publication No. US-2006/0190279 by Heflin ("Heflin"); Publication No. US-2003/022807 by
26 Hoffman ("Hoffman"); and Publication No. US-2005/0203768 by Florance ("Florance").

27 218. In a non-final rejection of the '194 application issued on January 28, 2014, the
28 USPTO notified Abhyanker that it considered all of these references relevant to the '194

1 application even though it had not specifically outlined their application under 35 U.S.C. §§ 102
2 or 103. The USPTO advised Abhyanker to review these references in particular.

3 219. That the USPTO identified these references as relevant in support of its rejection
4 of the '194 application, particularly in view of Abhyanker's argument of this application's
5 relevance to the '612 application's claims, confirms that the USPTO would have considered it to
6 be prior art material to the patentability of the '612 application.

7 220. Upon information and belief, and in view of the USPTO's conclusion that the '612
8 application's claims were entitled to an effective filing date of December 31, 2013, Abhyanker
9 knew that the USPTO would have considered these references to be prior art material to the
10 patentability of the '612 application.

11 221. Abhyanker nonetheless did not disclose Wheeler, Heflin, Hoffman, and Florance
12 during prosecution of the '612 application even though he knew that the USPTO would have
13 considered them to be prior art material to patentability.

14 222. Upon information and belief, Abhyanker specifically intended to deceive the
15 USPTO as to the existence of material prior art such as Wheeler, Heflin, Hoffman, and Florance.

16 **Failure to Disclose the Nextdoor.com Website**

17 223. Abhyanker also did not disclose the existence of Defendant's website,
18 Nextdoor.com, and services and features provided therein, in an information disclosure statement
19 during prosecution of the '612 application.

20 224. Nextdoor.com launched to the general public in October 2011, although it had
21 been in public beta testing since early 2011.

22 225. Given that Abhyanker has accused the Nextdoor.com website of infringing the
23 '545 patent, Abhyanker knew that the USPTO would have considered the Nextdoor.com website
24 material to patentability.

25 226. Given that the USPTO accorded the '612 application's claims an effective filing
26 date of December 31, 2013, Abhyanker knew that the USPTO would have considered
27 Nextdoor.com to be prior art to the '612 application.

28 227. Abhyanker nonetheless did not disclose the Nextdoor.com website during

1 prosecution of the '612 application even though he knew that the USPTO would have considered
2 it to be prior art material to patentability.

3 228. Upon information and belief, Abhyanker specifically intended to deceive the
4 USPTO as to the existence of material prior art such as the Nextdoor.com website.

5 Conclusion

6 229. In sum, on information and belief, Raj Abhyanker, the inventor and patent attorney
7 for the '545 patent, misrepresented and omitted material information with the intent to deceive the
8 USPTO to ensure the issuance of the '545 patent.

9 230. By reason of this inequitable conduct, the '545 patent and all related patents are
10 unenforceable.

11 231. The '545 patent is further unenforceable as a result of Abhyanker's inequitable
12 conduct committed during the prosecution of related patent applications, including without
13 limitation U.S. Patent Application Nos. 14/203,531, addressed below, and 14/151,844, addressed
14 above.

15 **FIFTEENTH DEFENSE: INEQUITABLE CONDUCT ('328 PATENT)**

16 Introduction

17 232. The '328 patent, and each claim thereof, is unenforceable due to inequitable
18 conduct during its prosecution.

19 233. During prosecution of the '328 patent, Raj Abhyanker ("Abhyanker") failed to
20 disclose, withheld, concealed, and/or mischaracterized information that he knew would have been
21 important to a reasonable examiner in determining whether to issue the patent.

22 234. Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized this
23 material information with a specific intent to deceive the United States Patent and Trademark
24 Office ("USPTO").

25 235. Abhyanker filed U.S. Patent Application No. 14/203,531 (the "'531 application")
26 on March 10, 2014. The '531 application issued as the '328 patent.

27 236. Abhyanker, the named inventor of the '531 application, served as patent
28 prosecution counsel for the '531 application.

237. Abhyanker's USPTO registration number, submitted with his filings in the '531 application, is Reg. No. 45474.

Improper Claims of Priority

238. Upon information and belief, Abhyanker, as a licensed patent attorney, is familiar with the rules governing the patent process.

239. Specifically, upon information and belief, Abhyanker knew at the time he filed the '531 application that in order to claim the benefit of an earlier application's priority date, 1) the invention disclosed in the earlier application must support the claims of the later application, and 2) the two applications must have been co-pending.

240. Abhyanker represented to the USPTO that the pending claims of the '531 application were entitled to claim priority to U.S. Patent Application 11/653,194 (the "'194 application"), filed on January 12, 2007, which in turned claimed priority to U.S. Patent Application No. 11/603,442 (the "'442 application"), filed on November 22, 2006.

241. Abhyanker further represented that the '442 and '194 applications disclosed each and every element of the pending claims of the '531 application by submitting a claim chart to that effect to the USPTO.

242. Additionally, the '531 application fails to meet the co-pendency requirement at least with respect to the '442 application because the '442 application was abandoned at the time Abhyanker filed the '531 application.

243. Upon information and belief, Abhyanker recognized that the '531 and '442 applications were not co-pending.

244. For this reason, Abhyanker sought to claim the benefit of the '442 application's priority date by claiming priority to the '194 application.

245. However, the '194 application's disclosure did not support the pending claims of the '531 application.

246. Upon information and belief, Abhyanker recognized that the '194 application's disclosure did not support the pending claims of the '531 application.

247. Therefore, in a preliminary amendment dated May 12, 2014, Abhyanker inserted

1 matter into the specification of the '531 application that is not found in the '194 application's
2 disclosure.

3 248. In the May 12, 2014 preliminary amendment, Abhyanker asserted that no new
4 matter had been added, but instead that such matter was incorporated from the '442 application.

5 249. This statement in the May 12, 2014 preliminary amendment is untrue. The '531
6 application adds new matter to the '194 application's disclosure.

7 250. Abhyanker's misrepresentations concerning the entitlement of the '531 application
8 to the priority dates of the '194 and '442 applications were material to patentability because the
9 examiner would have accorded the '531 application an effective filing date of no earlier than
10 March 10, 2014 absent these misrepresentations.

11 251. The examiner would have then considered numerous other references to be prior
12 art to the '531 application, including, without limitation, references describing the public use and
13 sale of Fatdoor services offered by a previous company called Fatdoor, Inc. ("Fatdoor I") of
14 which Raj Abhyanker, the CEO of the later entity, Plaintiff Fatdoor, Inc., also served as CEO.
15 One such reference is Kaplan, Dan, "Fatdoor turns neighborhoods into online social networks,"
16 May 28, 2007 ("Kaplan"), which was cited in a non-final rejection of the '844 application (which
17 issued as the '091 patent) on March 17, 2014.

18 252. That the USPTO cited Kaplan in a rejection of the '091 patent, which discloses
19 and claims similar subject matter as the '531 application and which claims priority to the same
20 '194 application, confirms that the USPTO would have considered Kaplan to be a material prior
21 art reference if it considered Kaplan to be prior art.

22 253. Thus, Abhyanker's claims of priority in the '531 application misrepresented
23 information material to patentability.

24 254. Upon information and belief, Abhyanker specifically intended to deceive the
25 USPTO as to whether the pending claims of the '531 application were entitled to the priority date
26 of the '194 application and the '442 application by extension.

27 **Misrepresentation Regarding AIA Rules**

28 255. In addition to his material misrepresentation of the '328 patent's priority date,

1 Abhyanker omitted material information when, during the '531 application's prosecution, he did
2 not indicate to the USPTO that the '328 patent application should be examined under the first-to-
3 file provisions of the America Invents Act ("AIA") because it has at least one claim with an
4 effective filing date after March 16, 2013.

5 256. Upon information and belief, Abhyanker, a licensed patent attorney, knew that the
6 '531 application, purportedly a continuation but in fact a continuation-in-part filed in 2014 and
7 containing new matter, had at least one claim with an effective date after March 16, 2013.

8 257. Nevertheless, Abhyanker did not check the box provided on a USPTO form to
9 indicate that the '531 application should be examined under AIA rules, upon information and
10 belief, with the specific intent of deceiving the USPTO and avoiding prior art, such as the public
11 use of Fatdoor services.

12 258. Had Abhyanker properly indicated that the '531 application should be examined
13 according to the AIA, one or more claims would have been accorded the March 10, 2014 '531
14 application filing date, and the USPTO would have rejected those claims in view of Kaplan.

15 259. Abhyanker's contention that the '531 application should be examined according to
16 pre-AIA rules misrepresented information material to patentability.

17 260. Upon information and belief, Abhyanker specifically intended to deceive the
18 USPTO as to whether the pending claims of the '531 application were entitled to be examined
19 under pre-AIA rules.

20 **Failure to Disclose References Relied on by USPTO During the Prosecution of the '844**
21 **Application**

22 261. The '091 patent that issued on the '844 application discloses and claims similar
23 subject matter as the '328 application. The '091 patent claims to be a continuation-in-part of the
24 '194 application, and the '328 claims to be a continuation of the '194 application.

25 262. Accordingly, material prior art to the '844 application would also have been
26 material prior art to the '531 application.

27 263. The USPTO cited several references in support of the non-final rejection of the
28 '844 application on March 17, 2014. These include U.S. Patent No. 8,650,103, by Wilf et al.

1 (“Wilf”); Publication No. US-2013/0282842, by Blecon et al. (“Blecon”); Publication No. US-
 2 2011/0231268, by Ungos (“Ungos”); and an article from Wired.com entitled “Fatdoor CEO Talks
 3 about balancing security with community,” by Russell (“Russell”).

4 264. That the USPTO cited these references in support of its rejection of the ’844
 5 application confirms that the USPTO would have considered them prior art material to the
 6 patentability of the ’531 application.

7 265. Abhyanker nonetheless did not disclose Wilf, Blecon, Ungos, or Russell during
 8 prosecution of the ’513 application even though he knew that the USPTO would have considered
 9 them to be prior art material to patentability.

10 266. Upon information and belief, Abhyanker specifically intended to deceive the
 11 USPTO as to the existence of material prior art such as Wilf, Blecon, Ungos, and Russell.

12 **Failure to Disclose Nextdoor.com Website**

13 267. Abhyanker also did not disclose the existence of Defendant’s website,
 14 Nextdoor.com, and services and features provided therein, in an information disclosure statement
 15 during prosecution of the ’531 application.

16 268. Nextdoor.com launched to the general public in October 2011, although it had
 17 been in public beta testing since early 2011.

18 269. Given that Abhyanker has accused the Nextdoor.com website of infringing the
 19 ’328 patent, Abhyanker knew that the USPTO would have considered the Nextdoor.com website
 20 material to patentability.

21 270. Upon information and belief, and in view of Abhyanker’s knowledge that his
 22 claims of priority were improper, as well his contemporaneous knowledge of the USPTO’s
 23 rejection of such a priority date in connection with the ’612 application that led to the ’545 patent,
 24 as explained below, Abhyanker knew that the USPTO would have considered Nextdoor.com to
 25 be prior art material to the patentability of the ’531 application.

26 271. Abhyanker nonetheless did not disclose the Nextdoor.com website during
 27 prosecution of the ’531 application even though he knew that the USPTO would have considered
 28 it to be prior art material to patentability.

272. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as the Nextdoor.com website.

Conclusion

273. In sum, on information and belief, Abhyanker, the inventor and patent attorney for the '328 patent, misrepresented and omitted material information with the intent to deceive the USPTO to ensure the issuance of the '328 patent.

274. By reason of this inequitable conduct, the '328 patent and all related patents are unenforceable.

275. The '328 patent is further unenforceable as a result of Abhyanker's inequitable conduct committed during the prosecution of related applications, including without limitation U.S. Patent Application Nos. 14/151,844, addressed above, and 14/144,612, addressed above.

SIXTEENTH DEFENSE: FAILURE TO JOIN AN INDISPENSABLE PARTY

276. Plaintiff has failed to join an indispensable party or parties to this action, including without limitation persons or entities who may have an ownership interest in the '328 patent, the '091 patent, and/or the '545 patent.

COUNTERCLAIMS

In addition to its affirmative defenses, Counterclaimant Nextdoor.com, Inc. further asserts the following counterclaims against Counterclaim Defendants Fatdoor, Inc. and Raj Abhyanker and alleges as follows:

THE PARTIES

1. Counterclaimant Nextdoor.com, Inc. ("Nextdoor") is a corporation organized and existing under the laws of the State of Delaware and has its principal place of business at 760 Market Street, Suite 300, San Francisco, CA 94102.

2. On information and belief and through its own admission in its Complaint, Counterclaim Defendant Fatdoor, Inc. is a Delaware corporation with its principal place of business in Mountain View, CA.

3. On information and belief, Counterclaim Defendant Raj Abhyanker ("Abhyanker") is an individual residing in Cupertino, CA. On information and belief, Abhyanker

1 is the alter ego of Fatdoor. In particular, on information and belief, Abhyanker directs and
2 controls the activities of Fatdoor without observing distinctions between his activities and those
3 of Fatdoor and uses Fatdoor as an instrumentality of his own interests, including, without
4 limitation, by freely transferring rights and assets as between himself and Fatdoor and other
5 entities that he controls, such that to recognize Fatdoor as a separate entity would cause inequity
6 and injustice. Fatdoor and its alter ego, Abhyanker, will be collectively referred to as “Fatdoor.”

7 THE PATENTS

8 4. U.S. Patent No. 8,775,328 (the “’328 patent”), entitled “Geo-Spatially Constrained
9 Private Social Network,” issued on July 8, 2014.

10 5. U.S. Patent No. 8,732,091 (the “’091 patent”), entitled “Security in a Geo-Spatial
11 Environment,” issued on May 20, 2014. Upon information and belief, Abhyanker purportedly
12 assigned certain interests in the ’091 patent to Fatdoor on June 18, 2014 and recorded an
13 assignment to that effect with the USPTO on the same day. Abhyanker purported to own a 50%
14 interest in the ’091 patent at the time this action was filed and, to the extent that he maintained
15 any such interests, Abhyanker continues to maintain certain interests in the ’091 patent.

16 6. U.S. Patent No. 8,738,545 (the “’545 patent”), entitled “Map Based Neighborhood
17 Search and Community Contribution,” issued on May 27, 2014, purportedly to Abhyanker. Upon
18 information and belief, Abhyanker purportedly assigned certain interests in the ’545 patent to
19 Fatdoor after the filing of Nextdoor’s original counterclaims. Abhyanker recorded an assignment
20 to that effect with the USPTO on June 25, 2014 that purports to have been executed on June 24,
21 2014. Upon information and belief, Abhyanker purported to own all interests in the ’545 patent
22 at the time of Nextdoor’s counterclaims and, to the extent that he maintained any such interests,
23 Abhyanker continues to maintain certain interests in the ’545 patent.

24 JURISDICTION AND VENUE

25 7. Nextdoor counterclaims against Fatdoor and Abhyanker pursuant to the patent
26 laws of the United States, Title 35 of the United States Code, laws authorizing actions for
27 declaratory judgment in the courts of the United States, 28 U.S.C. §§ 2201 and 2202, and Federal
28 Rule of Civil Procedure 13.

8. This Court has jurisdiction over these Counterclaims pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201(a), and 2202.

9. This Court has personal jurisdiction over Fatdoor and Abhyanker by virtue, *inter alia*, of their filing of the Complaint in this Court and their residence in this District.

10. Venue is proper in this District pursuant to 28 U.S.C. §§ 1391 and 1400.

11. An actual controversy exists between Nextdoor, on the one hand, and Fatdoor and Abhyanker, on the other, with respect to the '328 patent, the '091 patent, and the '545 patent, by virtue of the allegations of Fatdoor's FAC in this action and Nextdoor's answer thereto—*i.e.*, as to whether the '328 patent, the '091 patent, and the '545 patent are invalid and/or not infringed by Nextdoor's products and services.

**FIRST COUNTERCLAIM:
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '328 PATENT**

12. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

13. Fatdoor claims in its FAC to be the "full owner of interest in" the '328 patent.

14. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the '328 patent.

15. Nextdoor has not and does not infringe any valid and enforceable claim of the '328 patent, either literally or by the doctrine of equivalents.

16. Absent a declaration of non-infringement of the '328 patent, Fatdoor will continue to assert the '328 patent against Nextdoor and will in this way cause damage to Nextdoor.

17. Accordingly, Nextdoor is entitled to a judgment from this Court that the '328 patent is not infringed by any Nextdoor product or service, either literally or under the doctrine of equivalents.

**SECOND COUNTERCLAIM:
DECLARATORY JUDGMENT OF INVALIDITY OF THE '328 PATENT**

18. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

1 19. Fatdoor claims in its FAC to be the “full owner of interest in” the ’328 patent.

2 20. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the ’328
3 patent.

4 21. One or more claims of the ’328 patent are invalid for failure to meet one or more
5 of the conditions for patentability specified in Title 35, U.S.C., or the rules, regulations, and law
6 related thereto, including, without limitation, 35 U.S.C. §§ 101, 102, 103, and 112.

7 22. Absent a declaration of invalidity of the ’328 patent, Fatdoor will continue to
8 assert the ’091 patent against Nextdoor and will in this way cause damage to Nextdoor.

9 23. Accordingly, Nextdoor seeks a declaration that one or more claims of the ’328
10 patent are invalid.

11 **THIRD COUNTERCLAIM:**
12 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE ’091 PATENT**

13 24. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference
14 as if fully restated herein.

15 25. Fatdoor claims in its FAC to be the “full owner of interest in” the ’091 patent.
16 Abhyanker purports to have transferred certain ownership interests in the ’091 patent to Fatdoor,
17 Inc., but, upon information and belief, such transfer failed to transfer certain rights in the ’091
18 patent.

19 26. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the ’091
20 patent.

21 27. Nextdoor has not and does not infringe any valid and enforceable claim of the ’091
22 patent, either literally or by the doctrine of equivalents.

23 28. Absent a declaration of non-infringement of the ’091 patent, Counterclaim
24 Defendants will continue to assert the ’091 patent against Nextdoor and will in this way cause
25 damage to Nextdoor.

26 29. Accordingly, Nextdoor is entitled to a judgment from this Court that the ’091
27 patent is not infringed by any Nextdoor product or service, either literally or under the doctrine of
28 equivalents.

**FOURTH COUNTERCLAIM:
DECLARATORY JUDGMENT OF INVALIDITY OF THE '091 PATENT**

30. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

31. Fatdoor claims in its FAC to be the “full owner of interest in” the '091 patent. Abhyanker purports to have transferred certain ownership interests in the '091 patent to Fatdoor, Inc., but, upon information and belief, such transfer failed to transfer certain rights in the '091 patent.

32. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the '091 patent.

33. One or more claims of the '091 patent are invalid for failure to meet one or more of the conditions for patentability specified in Title 35, U.S.C., or the rules, regulations, and law related thereto, including, without limitation, 35 U.S.C. §§ 101, 102, 103, and 112.

34. Absent a declaration of invalidity of the '091 patent, Counterclaim Defendants will continue to assert the '091 patent against Nextdoor and will in this way cause damage to Nextdoor.

35. Accordingly, Nextdoor seeks a declaration that one or more claims of the '091 patent are invalid.

**FIFTH COUNTERCLAIM:
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '545 PATENT**

36. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

37. The '545 patent was issued by the United States Patent and Trademark office on May 27, 2014, purportedly to Abhyanker. Upon information and belief, Abhyanker purportedly assigned certain interests in the '545 patent to Fatdoor, Inc. after the filing of Nextdoor's original counterclaims. Abhyanker recorded an assignment to that effect with the USPTO on June 25, 2014 that purports to have been executed on June 24, 2014. Fatdoor now claims in its FAC to be the “full owner of interest in” the '545 patent. Upon information and belief, Abhyanker purported

1 to own all interests in the '545 patent at the time of Nextdoor's original counterclaims and, to the
 2 extent that he maintained any such interests, Abhyanker continues to maintain certain interests in
 3 the '545 patent.

4 38. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the '545
 5 patent.

6 39. Nextdoor has not and does not infringe any valid and enforceable claim of the '545
 7 patent, either literally or by the doctrine of equivalents.

8 40. Absent a declaration of non-infringement of the '545 patent, Counterclaim
 9 Defendants will continue to pursue claims of infringement with respect to the '545 patent against
 10 Nextdoor and will in this way cause damage to Nextdoor.

11 41. Accordingly, Nextdoor is entitled to a judgment from this Court that the '545
 12 patent is not infringed by any Nextdoor product or service, either literally or under the doctrine of
 13 equivalents.

14 **SIXTH COUNTERCLAIM:**
DECLARATORY JUDGMENT OF INVALIDITY OF THE '545 PATENT

15 42. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference
 16 as if fully restated herein.

17 43. The '545 patent was issued by the United States Patent and Trademark office on
 18 May 27, 2014, purportedly to Abhyanker. Upon information and belief, Abhyanker purportedly
 19 assigned certain interests in the '545 patent to Fatdoor, Inc. after the filing of Nextdoor's original
 20 counterclaims. Abhyanker recorded an assignment to that effect with the USPTO on June 25,
 21 2014 that purports to have been executed on June 24, 2014. Fatdoor now claims in its FAC to be
 22 the "full owner of interest in" the '545 patent. Upon information and belief, Abhyanker purported
 23 to own all interests in the '545 patent at the time of Nextdoor's original counterclaims and, to the
 24 extent that he maintained any such interests, Abhyanker continues to maintain certain interests in
 25 the '545 patent.

26 44. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the '545
 27 patent.
 28

45. One or more claims of the '545 patent are invalid for failure to meet one or more of the conditions for patentability specified in Title 35, U.S.C., or the rules, regulations, and law related thereto, including, without limitation, 35 U.S.C. §§ 101, 102, 103, and 112.

46. Absent a declaration of invalidity of the '545 patent, Counterclaim Defendants are likely to pursue claims of infringement with respect to the '545 patent against Nextdoor and will in this way cause damage to Nextdoor.

47. Accordingly, Nextdoor seeks a declaration that one or more claims of the '545 patent are invalid.

**SEVENTH COUNTERCLAIM:
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE '091 PATENT**

Introduction

48. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

49. The '091 patent, and each claim thereof, is unenforceable due to inequitable conduct during its prosecution.

50. During prosecution of the '091 patent, Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized information that he knew would have been important to a reasonable examiner in determining whether to issue the patent.

51. Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized this material information with a specific intent to deceive the United States Patent and Trademark Office ("USPTO").

52. Abhyanker filed U.S. Patent Application No. 14/151,844 (the "'844 application") on January 10, 2014. The '844 application issued as the '091 patent.

53. Abhyanker, the named inventor of the '844 application, served as patent prosecution counsel for the '844 application.

54. Abhyanker's USPTO registration number, submitted with his filings in the '844 application, is Reg. No. 45474.

Improper Claims of Priority

55. Upon information and belief, Abhyanker, as a licensed patent attorney, is familiar with the rules governing the patent process.

56. Specifically, upon information and belief, Abhyanker knew at the time he filed the '844 application that in order to claim the benefit of an earlier application's priority date, 1) the invention disclosed in the earlier application must support the claims of the later application, and 2) the two applications must have been co-pending.

57. The USPTO issued and mailed a non-final rejection on March 17, 2014, rejecting all pending claims of the '844 application in light of Kaplan, Dan, "Fatdoor turns neighborhoods into online social networks," May 28, 2007 ("Kaplan").

58. Kaplan described the public use and sale of Fatdoor services offered by a previous company called Fatdoor, Inc. ("Fatdoor I") which Raj Abhyanker, the CEO of the later entity, Plaintiff Fatdoor, Inc. also served as CEO.

59. Upon information and belief, Abhyanker and therefore Plaintiff Fatdoor, Inc. knew that Fatdoor I offered services similar to those claimed in the pending claims of the '844 application.

60. The USPTO rejected independent claim 1 of the '844 application as anticipated by Kaplan because it "discloses a neighborhood communication system: a privacy server: to verify that each user of the community network lives at a residence associated with a claimable residential address of the community network formed through a social community module of a privacy server using a processor and a memory; to obtain from each user of the community network, using the processor of a computing device, member data associated with each user, the member data including an address; to associate the address with a profile of each user; to determine a location of each user based on the member data; to store the member data in a database; and to obtain a personal address privacy preference from each user, the personal address privacy preference specifying if the address should be displayed to other users; and a mapping server associated with the privacy server through a network to generate a geospatial representation of a set of points on a map defining residences associated with each use of the

1 community network having the member data.”

2 61. The USPTO rejected independent claim 13 of the '844 application as anticipated
3 by Kaplan because it “discloses [a] method of organizing a community network, comprising:
4 verifying that each user of the community network lives at a residence associated with a
5 claimable residential address of the community network formed through a social community
6 module of a privacy server using a processor and a memory; obtaining from each user of the
7 community network, using the processor of a computing device, member data associated with
8 each user, the member data including an address; associating the address with a profile of each
9 user; determining a location of each user based on the member data; storing the member data in a
10 database; and obtaining a personal address privacy preference from each user, the personal
11 address privacy preference specifying if the address should be displayed to other users.”

12 62. The USPTO rejected independent claim 25 of the '844 application as anticipated
13 by Kaplan because it “discloses a neighborhood communication system comprising: a privacy
14 server: to verify that each user of the community network lives at a residence associated with a
15 claimable residential address of the community network formed through a social community
16 module of a privacy server using a processor and a memory; to obtain from each user of the
17 community network, using the processor of a computing device, member data associated with
18 each user, the member data including an address; to associate the address with a profile of each
19 user; to determine a location of each user based on the member data; to store the member data in a
20 database; and to obtain a personal address privacy preference from each user, the personal address
21 privacy preference specifying if the address should be displayed to other users; a network; and a
22 mapping server associated with the privacy server through a network: to generate a geospatial
23 representation of a set of points on a map defining residences associated with each use of the
24 community network having the member data, determine that a marker is colliding with another
25 marker simultaneously displayed in a map based on an overlap area of the marker with the
26 another marker, automatically create a group pointer that replaces the marker and the another
27 marker on the map, generate a view of the marker and the another marker when a user selects the
28 group pointer, and determine that the marker, the another marker, and different markers are

1 associated with a shared structure based on address data associated with occupants represented
2 through the marker, the another marker and the different markers.”

3 63. Abhyanker submitted a Response to Non-Final Office Action on March 26, 2014
4 (the “Response”).

5 64. In the Response, Abhyanker contested the USPTO’s determination that Kaplan
6 anticipated the pending claims of the ’844 application.

7 65. Abhyanker represented to the USPTO that Kaplan was disqualified as prior art on
8 the ground that the ’844 application was entitled to a priority date of March 17, 2006.

9 66. Abhyanker represented to the USPTO that the pending claims of the ’844
10 application were entitled to claim priority to U.S. Patent Application 11/653,194 (the “’194
11 application”), filed on January 12, 2007, which in turned claimed priority to U.S. Patent
12 Application No. 11/603,442 (the “’442 application”), filed on November 22, 2006.

13 67. The ’442 application claims priority to U.S. Provisional Application 60/783,226,
14 filed on March 17, 2006.

15 68. Abhyanker’s claims for priority in the ’844 application to the ’442 and ’194
16 applications are improper. For example, a pending claim is entitled to the benefit of the filing
17 date of an earlier-filed application only if that earlier-filed application discloses each and every
18 element of the pending claim.

19 69. As such, by representing to the USPTO that the pending claims of the ’844
20 application were entitled to the filing dates of the ’194 and ’442 applications, Abhyanker in effect
21 represented that the specifications of the ’194 and ’442 applications each fully disclosed the
22 subject matter of the pending claims of the ’844 application.

23 70. This representation by Abhyanker to the USPTO as to the ’194 application was
24 incorrect. None of the pending ’844 claims was supported by the ’194 application.

25 71. By way of example, the concept of a “privacy preference,” a central feature of all
26 claims of the ’844 application, is found nowhere in the disclosures of the ’194 application.

27 72. Similarly, Abhyanker’s representation to the USPTO as to the ’442 application
28 was incorrect. None of the pending claims in the ’844 application was supported by the ’442

1 application

2 73. By way of example, the concept of a “privacy preference,” a central feature of all
3 claims of the ’844 application, is found nowhere in the disclosures of the ’442 application.

4 74. On information and belief, Abhyanker intentionally made these representations,
5 knowing them to be incorrect, in order to mislead the USPTO as to the content of the ’442 and
6 ’194 applications.

7 75. Abhyanker is the sole inventor listed on the ’442 and ’194 applications, filed in
8 2006 and 2007 respectively. Abhyanker thus is familiar with the subject matter disclosed in those
9 applications.

10 76. Given his status the sole inventor of the ’442 and ’194 applications, Abhyanker
11 knew that those applications did not fully support the pending claims of the ’844 application,
12 including without limitation that those applications did not disclose a “privacy preference.”

13 77. Additionally, the ’844 application fails to meet the co-pendency requirement at
14 least with respect to the ’442 application. The ’442 application was abandoned on June 24, 2009.
15 Abhyanker later filed the ’844 application on January 10, 2014, identifying the ’844 application
16 as a continuation-in-part of the ’442 application.

17 78. Thus, the ’844 application and ’442 application were not co-pending.

18 79. Upon information and belief, Abhyanker recognized after he filed the ’844
19 application that co-pendency was lacking.

20 80. On January 21, 2014—over four years after the ’442 application was abandoned
21 and eleven days after filing the ’844 application—Abhyanker filed a request for continued
22 examination of the ’442 application in a sham effort to establish co-pendency.

23 81. However, because the ’442 application was abandoned at the time Abhyanker filed
24 the ’844 application, the ’844 application was not co-pending with the ’442 application.

25 82. Upon information and belief, Abhyanker knew that the ’442 application and ’194
26 application disclosures did not support any of the pending claims of the ’844 application and that
27 co-pendency was lacking at least between the ’091 patent application and the ’442 application.

28 83. Abhyanker’s misrepresentations concerning the co-pendency of the ’442

1 application and the entitlement of the '844 application to the priority dates of the '194 and '442
2 applications were material, as evidenced at least by the USPTO's rejection of the pending claims
3 of the '844 application in light of Kaplan and the USPTO's withdrawal its rejection in response to
4 Abhyanker's misrepresentations concerning the '194 and '442 applications.

5 84. Absent these misrepresentations, the USPTO would not have disqualified Kaplan
6 as prior art.

7 85. Moreover, upon information and belief, Abhyanker knew that his improper claims
8 of priority to the '442 and '194 applications were material to the patentability of the pending
9 claims of the '844 application.

10 86. Abhyanker exhibited as much during the prosecution of the '844 application. As
11 noted above, in his Response, Abhyanker argued that Kaplan should be disqualified because the
12 pending claims of the '844 application were entitled to claim the benefit of the '194 and '442
13 applications.

14 87. Upon further information and belief, Abhyanker had the specific intent of claiming
15 priority to the '442 and '194 applications in an attempt to deceive the USPTO and avoid prior art,
16 such as the public use of the Fatdoor services by Fatdoor I, that a reasonable examiner would rely
17 upon to reject the pending claims of the '844 application. Those claims, now issued as the '091
18 patent, would stand rejected but for Abhyanker's improper claims of priority to the '194 and '442
19 applications.

20 88. Abhyanker's claims of priority in the '844 application misrepresented information
21 material to patentability.

22 89. Upon information and belief, Abhyanker specifically intended to deceive the
23 USPTO as to whether the pending claims of the '844 application were entitled to the priority date
24 of either the '194 application or '442 application.

25 **Misrepresentation Regarding AIA Rules**

26 90. In addition to his material misrepresentation of the '091 patent's priority date,
27 Abhyanker omitted material information when, during the '844 application's prosecution, he did
28 not indicate to the USPTO that the '091 patent application should be examined under the first-to-

1 file provisions of the America Invents Act (“AIA”) because it has at least one claim with an
2 effective filing date after March 16, 2013.

3 91. Upon information and belief, Abhyanker, a licensed patent attorney, knew that the
4 ’844 application, a continuation-in-part filed in 2014, had at least one claim with an effective date
5 after March 16, 2013.

6 92. Nevertheless, Abhyanker did not check the box provided on a USPTO form to
7 indicate that the ’844 application should be examined under AIA rules, upon information and
8 belief, with the specific intent of deceiving the USPTO and avoiding prior art, such as the public
9 use of Fatdoor services.

10 93. Had Abhyanker properly indicated that the ’844 application should be examined
11 according to the AIA, one or more claims would have been accorded the January 10, 2014 ’844
12 application filing date, and the USPTO would have rejected those claims in view of Kaplan.

13 94. Abhyanker’s contention that the ’844 application should be examined according to
14 pre-AIA rules misrepresented information material to patentability.

15 95. Upon information and belief, Abhyanker specifically intended to deceive the
16 USPTO as to whether the pending claims of the ’844 application were entitled to be examined
17 under pre-AIA rules.

18 **Failure to Disclose References Relied on by the USPTO During Prosecution of Another**
19 **Patent Application**

20 96. During prosecution of the ’844 application, Abhyanker contended that the ’844
21 application was entitled to the benefit of the ’194 application’s priority date.

22 97. This contention was an effort to support his improper priority claims.

23 98. Accordingly, and by Abhyanker’s own representation, the ’194 application
24 discloses similar subject matter to that claimed by the ’844 application.

25 99. Abhyanker did not disclose the following references to the USPTO during the
26 prosecution of the ’844 application: Publication No. US-2001/0005829 by Raveis (“Raveis”);
27 Publication No. US-2006/0022048 by Johnson (“Johnson”); and Publication No. US-
28 2007/1056429 by Godar (“Godar”).

100. The USPTO cited Raevis in support of a non-final rejection of the '194 application issued on May 10, 2011.

101. The USPTO cited Johnson in support of a final rejection of the '194 application issued on December 10, 2012.

102. The USPTO cited Godar in support of a non-final rejection of the '194 application issued on January 28, 2014.

103. That the USPTO cited these references in support of its rejection of the '194 application, particularly in view of Abhyanker's argument of this application's relevance to the '844 application's claims, confirms that the USPTO would have considered them prior art material to the patentability of the '844 application.

104. Upon information and belief, and in view of Abhyanker's knowledge that his claims of priority were improper (as well his contemporaneous knowledge of the USPTO's rejection of such a priority date in connection with the '612 application that led to the '545 patent, as explained below), Abhyanker knew that the USPTO would have considered these references to be prior art material to the patentability of the '844 application.

105. Abhyanker nonetheless did not disclose Raevis, Johnson, or Godar during prosecution of the '844 application even though he knew that the USPTO would have considered them to be prior art material to patentability.

106. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as Raevis, Johnson, and Godar.

Failure to Disclose References Identified by the USPTO During Prosecution of Another Patent Application

107. Abhyanker also did not disclose the following references to the USPTO during the prosecution of the '844 application: Publication No. US-2004/0039581 by Wheeler ("Wheeler"); Publication No. US-2006/0190279 by Heflin ("Heflin"); Publication No. US-2003/022807 by Hoffman ("Hoffman"); and Publication No. US-2005/0203768 by Florance ("Florance").

108. In a non-final rejection of the '194 application issued on January 28, 2014, the USPTO notified Abhyanker that it considered all of these references relevant to the '194

1 application even though it had not specifically outlined their application under 35 U.S.C. §§ 102
2 or 103. The USPTO advised Abhyanker to review these references in particular.

3 109. That the USPTO identified these references as relevant in support of its rejection
4 of the '194 application, particularly in view of Abhyanker's arguments that the '194 application
5 fully discloses the invention(s) claimed in the '844 application, confirms that the USPTO would
6 have considered it to be prior art material to the patentability of the '844 application.

7 110. Upon information and belief, and in view of Abhyanker's knowledge that his
8 claims of priority were improper (as well his contemporaneous knowledge of the USPTO's
9 rejection of such a priority date in connection with the '612 application that led to the '545 patent,
10 as explained below), Abhyanker knew that the USPTO would have considered these references to
11 be prior art material to the patentability of the '844 application.

12 111. Abhyanker nonetheless did not disclose Wheeler, Heflin, Hoffman, or Florance
13 during prosecution of the '844 application even though he knew that the USPTO would have
14 considered them to be prior art material to patentability.

15 112. Upon information and belief, Abhyanker specifically intended to deceive the
16 USPTO as to the existence of material prior art such as Wheeler, Heflin, Hoffman, and Florance.

17 **Failure to Disclose Nextdoor.com Website**

18 113. Abhyanker also did not disclose the existence of Defendant's website,
19 Nextdoor.com, and services and features provided therein, in an information disclosure statement
20 during prosecution of the '844 application.

21 114. Nextdoor.com launched to the general public in October 2011, although it had
22 been in public beta testing since early 2011.

23 115. Given that Abhyanker has, on the day of issuance, accused the Nextdoor.com
24 website of infringing the '091 patent, Abhyanker knew that the USPTO would have considered
25 the Nextdoor.com website material to patentability.

26 116. Upon information and belief, and in view of Abhyanker's knowledge that his
27 claims of priority were improper, as well his contemporaneous knowledge of the USPTO's
28 rejection of such a priority date in connection with the '612 application that led to the '545 patent,

1 as explained below, Abhyanker knew that the USPTO would have considered Nextdoor.com to
2 be prior art material to the patentability of the '844 application.

3 117. Abhyanker nonetheless did not disclose the Nextdoor.com website during
4 prosecution of the '844 application even though he knew that the USPTO would have considered
5 it to be prior art material to patentability.

6 118. Upon information and belief, Abhyanker specifically intended to deceive the
7 USPTO as to the existence of material prior art such as the Nextdoor.com website.

8 **Conclusion**

9 119. In sum, on information and belief, Abhyanker, the inventor and patent attorney for
10 the '091 patent, misrepresented and omitted material information with the intent to deceive the
11 USPTO to ensure the issuance of the '091 patent.

12 120. By reason of this inequitable conduct, the '091 patent and all related patents are
13 unenforceable.

14 121. Absent a declaration of unenforceability of the '091 patent, Counterclaim
15 Defendants are likely to continue to pursue claims of infringement with respect to the '091 patent
16 against Nextdoor and will in this way cause damage to Nextdoor.

17 122. The '091 patent is further unenforceable as a result of Abhyanker's inequitable
18 conduct committed during the prosecution of related patent applications, including without
19 limitation U.S. Patent Application No. 14/203,531, addressed below, and U.S. Patent Application
20 No. 14/144,612, addressed below.

21 123. Accordingly, Nextdoor seeks a declaration that the '091 patent is unenforceable.

22 **EIGHTH COUNTERCLAIM:** 23 **DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE '545 PATENT**

24 **Introduction**

25 124. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference
26 as if fully restated herein.

27 125. The '545 patent, and each claim thereof, is unenforceable due to inequitable
28 conduct during its prosecution.

1 136. Abhyanker submitted a response to the non-final office action on March 10, 2014
2 (the “’612 Response”).

3 137. In the ’612 Response, Abhyanker contested the USPTO’s determination that the
4 claims of the ’612 application were entitled to an effective filing date of December 31, 2013.

5 138. Abhyanker represented to the USPTO that the pending claims of the ’612
6 application were entitled to claim priority to the ’194 application, filed on January 12, 2007,
7 which in turned claimed priority to the ’442, filed on November 22, 2006.

8 139. The ’442 application claims priority to U.S. Provisional Application 60/783,226,
9 filed on March 17, 2006.

10 140. Abhyanker’s claims for priority in the ’844 application to the ’442 and ’194
11 applications are improper. For example, a pending claim is entitled to the benefit of the filing
12 date of an earlier-filed application only if that earlier-filed application discloses each and every
13 element of the pending claim.

14 141. In the Response, Abhyanker specifically represented that the pending claims of the
15 ’612 application were “entirely supported” in the specification of the ’194 application, as well as
16 by the specifications of two other patent applications, Nos. 11/731,465 (the “’465 application”)
17 and 11/827,400 (the “’400 application”).

18 142. This representation by Abhyanker to the USPTO as to the ’194, ’465, and ’400
19 applications was incorrect. None of the pending claims of the ’612 application was supported by
20 these applications.

21 143. By way of example, the concept of conducting “high value crime and safety
22 related discussions,” which is central to all claims of the ’612 application, is found nowhere in the
23 disclosures of the ’194, ’465, or ’400 applications.

24 144. On information and belief, Abhyanker, a licensed patent attorney, intentionally
25 made these representations, knowing them to be incorrect, in order to mislead the USPTO as to
26 the content of the ’194, ’465, and ’400 applications.

27 145. Abhyanker is the sole inventor listed on the ’194, ’465, and ’400 applications, all
28 filed in 2007. Abhyanker thus is familiar with the subject matter disclosed in those applications.

146. Given his status as the sole inventor of the '194, '465, and '400 applications, Abhyanker knew that those applications did not fully support the pending claims of the '612 application, including without limitation that those applications did not disclose the concept of conducting "high value crime and safety related discussions."

147. Additionally, the '612 application fails to meet the co-pendency requirement at least with respect to the '442 application. The '442 application was abandoned on June 24, 2009. Abhyanker later filed the '612 application on December 31, 2013.

148. Thus, the '612 application and '442 application were not co-pending.

149. Upon information and belief, Abhyanker recognized after he filed the '612 application that co-pendency was lacking.

150. On January 21, 2014—over four years after the '442 application was abandoned and twenty-one days after filing the '612 application—Abhyanker filed a request for continued examination of the '442 application in a sham effort to establish co-pendency.

151. However, because the '442 application was abandoned at the time Abhyanker filed the '612 application, the '612 application was not co-pending with the '442 application.

152. Upon information and belief, Abhyanker knew that the '442 application and '194 application disclosures did not support any of the pending claims of the '612 application and that co-pendency was lacking at least between the '612 patent application and the '442 application.

153. Abhyanker nonetheless represented in the Response of March 10, 2014 that the '612 application was entitled to the benefit of the '442 application's priority date.

Failure to Disclose Kaplan Reference Relied on by the USPTO or Other Fatdoor References During the Prosecution of Another Application

154. Abhyanker also did not disclose the following reference to the USPTO during the prosecution of the '612 application: Kaplan, Dan, "Fatdoor turns neighborhoods into online social networks," May 28, 2007 ("Kaplan").

155. Kaplan describes the public use and sale of Fatdoor services offered by a previous company called Fatdoor, Inc. ("Fatdoor I") of which Raj Abhyanker, the CEO of the later entity, Plaintiff Fatdoor, Inc. also served as CEO.

156. More generally, Abhyanker failed to disclose any references describing services offered by Fatdoor I, including the fatdoor.com website.

157. Upon information and belief, Abhyanker knew that Fatdoor I offered services similar to those claimed in the pending claims of the '612 application.

158. Abhyanker became aware of Kaplan in particular no later than March 17, 2014, at which time Kaplan was cited by the USPTO during prosecution of the '844 application in connection with a non-final rejection.

159. Abhyanker did not disclose the office action wherein the examiner cited Kaplan.

160. Abhyanker was personally involved in the development of Fatdoor I and was aware of services made publicly available at fatdoor.com.

161. The '091 and '545 patents disclose and claim similar subject matter, and the '091 patent claims to be a continuation-in-part of the '612 application.

162. Accordingly, material prior art to the '844 application would also have been material prior art to the '612 application.

163. Upon information and belief, Abhyanker knew that the USPTO would have found Kaplan to be material to patentability because the USPTO had previously relied on Kaplan in issuing a rejection of the '844 application.

164. During the prosecution of the '844 application, Abhyanker argued that Kaplan was not prior art to the '844 application because the '844 application was entitled to a priority date prior to Kaplan's publication date of May 28, 2007, in particular, that of the '442 application, filed November 22, 2006.

165. During the prosecution of the '612 application, Abhyanker argued that the '612 patent was also entitled to the '442 application's priority date.

166. The USPTO rejected Abhyanker's claim of priority for the '612 application, instead according its claims an effective filing date of December 31, 2013. The USPTO accordingly examined the '612 application under AIA rules.

167. Upon information and belief, Abhyanker knew that the USPTO would have considered Kaplan to be prior art to the '612 application.

168. Abhyanker nonetheless did not disclose Kaplan during prosecution of the '612 application even though he knew that the USPTO would have considered Kaplan to be prior art material to patentability.

169. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as Kaplan.

170. Upon information and belief, because Kaplan describes the operation of services then available at fatdoor.com, Abhyanker knew that the USPTO would have considered fatdoor.com, or any reference describing it, to be prior art to the '612 application.

171. Abhyanker nonetheless did not disclose fatdoor.com, or any reference describing it, during prosecution of the '612 application even though he knew that the USPTO would have considered them to be prior art material to patentability.

172. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as fatdoor.com or any reference describing it.

Failure to Disclose Other References Relied on by the USPTO
During the Prosecution of the '844 Application

173. The USPTO cited several other references in support of the non-final rejection of the '844 application on March 17, 2014. These include U.S. Patent No. 8,650,103, by Wilf et al. ("Wilf"); Publication No. US-2013/0282842, by Blecon et al. ("Blecon"); Publication No. US-2011/0231268, by Ungos ("Ungos"); and an article from Wired.com entitled "Fatdoor CEO Talks about balancing security with community," by Russell ("Russell").

174. That the USPTO cited these references in support of its rejection of the '844 application confirms that the USPTO would have considered them prior art material to the patentability of the '612 application.

175. Upon information and belief, and in view of the USPTO's conclusion that the '612 application's claims were entitled to an effective filing date of December 31, 2013, Abhyanker knew that the USPTO would have considered these references to be prior art material to the patentability of the '612 application.

176. Abhyanker nonetheless did not disclose Wilf, Blecon, Ungos, or Russell during prosecution of the '612 application even though he knew that the USPTO would have considered them to be prior art material to patentability.

177. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as Wilf, Blecon, Ungos, and Russell.

Failure to Disclose References Relied on by the USPTO During the Prosecution of the '194 and '400 Applications

178. In addition, during prosecution of the '612 application, Abhyanker argued, in a March 10, 2014 response to a March 6, 2014 non-final rejection, that the independent claims of the '612 application "are entirely supported" in the specifications of the '194, '465, and '400 applications.

179. Accordingly, and by Abhyanker's own representation, the '194, '465, and '400 applications disclose similar subject matter to that claimed by the '612 application.

180. Abhyanker did not disclose the following references to the USPTO during the prosecution of the '612 application: Publication No. US-2001/0005829 by Raveis ("Raveis"); Publication No. US-2006/0022048 by Johnson ("Johnson"); Publication No. US-2007/1056429 by Godar ("Godar"); Publication No. 2008/0125969 by Chen ("Chen"); and Publication No. 2007/0203644 by Thota ("Thota").

181. The USPTO cited Raveis in support of a non-final rejection of the '194 application issued on May 10, 2011.

182. The USPTO cited Johnson in support of a final rejection of the '194 application issued on December 10, 2012.

183. The USPTO cited Godar in support of a non-final rejection of the '194 application issued on January 28, 2014.

184. The USPTO cited Chen and Thota in support of a non-final rejection of the '400 application issued on April 12, 2011.

185. That the USPTO cited these references in support of its rejection of the '194 and '400 applications, particularly in view of Abhyanker's argument of these applications' relevance

1 to the '612 application's claims, confirms that the USPTO would have considered them prior art
2 material to the patentability of the '612 application.

3 186. Upon information and belief, and in view of the USPTO's conclusion that the '612
4 application's claims were entitled to an effective filing date of December 31, 2013, Abhyanker
5 knew that the USPTO would have considered these references to be prior art material to the
6 patentability of the '612 application.

7 187. Abhyanker nonetheless did not disclose Raevis, Johnson, Godar, Chen, and Thota
8 during prosecution of the '612 application even though he knew that the USPTO would have
9 considered them to be prior art material to patentability.

10 188. Upon information and belief, Abhyanker specifically intended to deceive the
11 USPTO as to the existence of material prior art such as Raevis, Johnson, Godar, Chen, and Thota.

12 **Failure to Disclose References Identified by the USPTO**
13 **During the Prosecution of the '194 Application**

14 189. Abhyanker also did not disclose the following references to the USPTO during the
15 prosecution of the '612 application: Publication No. US-2004/0039581 by Wheeler ("Wheeler");
16 Publication No. US-2006/0190279 by Heflin ("Heflin"); Publication No. US-2003/022807 by
17 Hoffman ("Hoffman"); and Publication No. US-2005/0203768 by Florance ("Florance").

18 190. In a non-final rejection of the '194 application issued on January 28, 2014, the
19 USPTO notified Abhyanker that it considered all of these references relevant to the '194
20 application even though it had not specifically outlined their application under 35 U.S.C. §§ 102
21 or 103. The USPTO advised Abhyanker to review these references in particular.

22 191. That the USPTO identified these references as relevant in support of its rejection
23 of the '194 application, particularly in view of Abhyanker's argument of this application's
24 relevance to the '612 application's claims, confirms that the USPTO would have considered it to
25 be prior art material to the patentability of the '612 application.

26 192. Upon information and belief, and in view of the USPTO's conclusion that the '612
27 application's claims were entitled to an effective filing date of December 31, 2013, Abhyanker
28 knew that the USPTO would have considered these references to be prior art material to the

1 patentability of the '612 application.

2 193. Abhyanker nonetheless did not disclose Wheeler, Heflin, Hoffman, and Florance
3 during prosecution of the '612 application even though he knew that the USPTO would have
4 considered them to be prior art material to patentability.

5 194. Upon information and belief, Abhyanker specifically intended to deceive the
6 USPTO as to the existence of material prior art such as Wheeler, Heflin, Hoffman, and Florance.

7 **Failure to Disclose the Nextdoor.com Website**

8 195. Abhyanker also did not disclose the existence of Defendant's website,
9 Nextdoor.com, and services and features provided therein, in an information disclosure statement
10 during prosecution of the '612 application.

11 196. Nextdoor.com launched to the general public in October 2011, although it had
12 been in public beta testing since early 2011.

13 197. Given that Abhyanker has accused the Nextdoor.com website of infringing the
14 '545 patent, Abhyanker knew that the USPTO would have considered the Nextdoor.com website
15 material to patentability.

16 198. Given that the USPTO accorded the '612 application's claims an effective filing
17 date of December 31, 2013, Abhyanker knew that the USPTO would have considered
18 Nextdoor.com to be prior art to the '612 application.

19 199. Abhyanker nonetheless did not disclose the Nextdoor.com website during
20 prosecution of the '612 application even though he knew that the USPTO would have considered
21 it to be prior art material to patentability.

22 200. Upon information and belief, Abhyanker specifically intended to deceive the
23 USPTO as to the existence of material prior art such as the Nextdoor.com website.

24 **Conclusion**

25 201. In sum, on information and belief, Raj Abhyanker, the inventor and patent attorney
26 for the '545 patent, misrepresented and omitted material information with the intent to deceive the
27 USPTO to ensure the issuance of the '545 patent.

28 202. By reason of this inequitable conduct, the '545 patent and all related patents are

unenforceable.

203. Absent a declaration of unenforceability of the '545 patent, Counterclaim Defendants are likely to continue to pursue claims of infringement with respect to the '545 patent against Nextdoor and will in this way cause damage to Nextdoor.

204. The '545 patent is further unenforceable as a result of Abhyanker's inequitable conduct committed during the prosecution of related patent applications, including without limitation U.S. Patent Application Nos. 14/203,531, addressed below, and 14/151,844, addressed above.

205. Accordingly, Nextdoor seeks a declaration that the '545 patent is unenforceable.

**NINTH COUNTERCLAIM:
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE '328 PATENT**

Introduction

206. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

207. The '328 patent, and each claim thereof, is unenforceable due to inequitable conduct during its prosecution.

208. During prosecution of the '328 patent, Raj Abhyanker ("Abhyanker") failed to disclose, withheld, concealed, and/or mischaracterized information that he knew would have been important to a reasonable examiner in determining whether to issue the patent.

209. Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized this material information with a specific intent to deceive the United States Patent and Trademark Office ("USPTO").

210. Abhyanker filed U.S. Patent Application No. 14/203,531 (the "'531 application") on March 10, 2014. The '531 application issued as the '328 patent.

211. Abhyanker, the named inventor of the '531 application, served as patent prosecution counsel for the '531 application.

212. Abhyanker's USPTO registration number, submitted with his filings in the '531 application, is Reg. No. 45474.

Improper Claims of Priority

213. Upon information and belief, Abhyanker, as a licensed patent attorney, is familiar with the rules governing the patent process.

214. Specifically, upon information and belief, Abhyanker knew at the time he filed the '531 application that in order to claim the benefit of an earlier application's priority date, 1) the invention disclosed in the earlier application must support the claims of the later application, and 2) the two applications must have been co-pending.

215. Abhyanker represented to the USPTO that the pending claims of the '531 application were entitled to claim priority to U.S. Patent Application 11/653,194 (the "'194 application"), filed on January 12, 2007, which in turned claimed priority to U.S. Patent Application No. 11/603,442 (the "'442 application"), filed on November 22, 2006.

216. Abhyanker further represented that the '442 and '194 applications disclosed each and every element of the pending claims of the '531 application by submitting a claim chart to that effect to the USPTO.

217. Additionally, the '531 application fails to meet the co-pendency requirement at least with respect to the '442 application because the '442 application was abandoned at the time Abhyanker filed the '531 application.

218. Upon information and belief, Abhyanker recognized that the '531 and '442 applications were not co-pending.

219. For this reason, Abhyanker sought to claim the benefit of the '442 application's priority date by claiming priority to the '194 application.

220. However, the '194 application's disclosure did not support the pending claims of the '531 application.

221. Upon information and belief, Abhyanker recognized that the '194 application's disclosure did not support the pending claims of the '531 application.

222. Therefore, in a preliminary amendment dated May 12, 2014, Abhyanker inserted matter into the specification of the '531 application that is not found in the '194 application's disclosure.

223. In the May 12, 2014 preliminary amendment, Abhyanker asserted that no new matter had been added, but instead that such matter was incorporated from the '442 application.

224. This statement in the May 12, 2014 preliminary amendment is untrue. The '531 application adds new matter to the '194 application's disclosure.

225. Abhyanker's misrepresentations concerning the entitlement of the '531 application to the priority dates of the '194 and '442 applications were material to patentability because the examiner would have accorded the '531 application an effective filing date of no earlier than March 10, 2014 absent these misrepresentations.

226. The examiner would have then considered numerous other references to be prior art to the '531 application, including, without limitation, references describing the public use and sale of Fatdoor services offered by a previous company called Fatdoor, Inc. ("Fatdoor I") of which Raj Abhyanker, the CEO of the later entity, Plaintiff Fatdoor, Inc., also served as CEO. One such reference is Kaplan, Dan, "Fatdoor turns neighborhoods into online social networks," May 28, 2007 ("Kaplan"), which was cited in a non-final rejection of the '844 application (which issued as the '091 patent) on March 17, 2014.

227. That the USPTO cited Kaplan in a rejection of the '091 patent, which discloses and claims similar subject matter as the '531 application and which claims priority to the same '194 application, confirms that the USPTO would have considered Kaplan to be a material prior art reference if it considered Kaplan to be prior art.

228. Thus, Abhyanker's claims of priority in the '531 application misrepresented information material to patentability.

229. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to whether the pending claims of the '531 application were entitled to the priority date of the '194 application and the '442 application by extension.

Misrepresentation Regarding AIA Rules

230. In addition to his material misrepresentation of the '328 patent's priority date, Abhyanker omitted material information when, during the '531 application's prosecution, he did not indicate to the USPTO that the '328 patent application should be examined under the first-to-

1 file provisions of the America Invents Act (“AIA”) because it has at least one claim with an
2 effective filing date after March 16, 2013.

3 231. Upon information and belief, Abhyanker, a licensed patent attorney, knew that the
4 ’531 application, purportedly a continuation but in fact a continuation-in-part filed in 2014 and
5 containing new matter, had at least one claim with an effective date after March 16, 2013.

6 232. Nevertheless, Abhyanker did not check the box provided on a USPTO form to
7 indicate that the ’531 application should be examined under AIA rules, upon information and
8 belief, with the specific intent of deceiving the USPTO and avoiding prior art, such as the public
9 use of Fatdoor services.

10 233. Had Abhyanker properly indicated that the ’531 application should be examined
11 according to the AIA, one or more claims would have been accorded the March 10, 2014 ’531
12 application filing date, and the USPTO would have rejected those claims in view of Kaplan.

13 234. Abhyanker’s contention that the ’531 application should be examined according to
14 pre-AIA rules misrepresented information material to patentability.

15 235. Upon information and belief, Abhyanker specifically intended to deceive the
16 USPTO as to whether the pending claims of the ’531 application were entitled to be examined
17 under pre-AIA rules.

18 **Failure to Disclose References Relied on by USPTO During the Prosecution of the ’844**
19 **Application**

20 236. The ’091 patent that issued on the ’844 application discloses and claims similar
21 subject matter as the ’328 application. The ’091 patent claims to be a continuation-in-part of the
22 ’194 application, and the ’328 claims to be a continuation of the ’194 application.

23 237. Accordingly, material prior art to the ’844 application would also have been
24 material prior art to the ’531 application.

25 238. The USPTO cited several references in support of the non-final rejection of the
26 ’844 application on March 17, 2014. These include U.S. Patent No. 8,650,103, by Wilf et al.
27 (“Wilf”); Publication No. US-2013/0282842, by Blecon et al. (“Blecon”); Publication No. US-
28 2011/0231268, by Ungos (“Ungos”); and an article from Wired.com entitled “Fatdoor CEO Talks

1 about balancing security with community,” by Russell (“Russell”).

2 239. That the USPTO cited these references in support of its rejection of the ’844
3 application confirms that the USPTO would have considered them prior art material to the
4 patentability of the ’531 application.

5 240. Abhyanker nonetheless did not disclose Wilf, Blecon, Ungos, or Russell during
6 prosecution of the ’513 application even though he knew that the USPTO would have considered
7 them to be prior art material to patentability.

8 241. Upon information and belief, Abhyanker specifically intended to deceive the
9 USPTO as to the existence of material prior art such as Wilf, Blecon, Ungos, and Russell.

10 **Failure to Disclose Nextdoor.com Website**

11 242. Abhyanker also did not disclose the existence of Defendant’s website,
12 Nextdoor.com, and services and features provided therein, in an information disclosure statement
13 during prosecution of the ’531 application.

14 243. Nextdoor.com launched to the general public in October 2011, although it had
15 been in public beta testing since early 2011.

16 244. Given that Abhyanker has accused the Nextdoor.com website of infringing the
17 ’328 patent, Abhyanker knew that the USPTO would have considered the Nextdoor.com website
18 material to patentability.

19 245. Upon information and belief, and in view of Abhyanker’s knowledge that his
20 claims of priority were improper, as well his contemporaneous knowledge of the USPTO’s
21 rejection of such a priority date in connection with the ’612 application that led to the ’545 patent,
22 as explained below, Abhyanker knew that the USPTO would have considered Nextdoor.com to
23 be prior art material to the patentability of the ’531 application.

24 246. Abhyanker nonetheless did not disclose the Nextdoor.com website during
25 prosecution of the ’531 application even though he knew that the USPTO would have considered
26 it to be prior art material to patentability.

27 247. Upon information and belief, Abhyanker specifically intended to deceive the
28 USPTO as to the existence of material prior art such as the Nextdoor.com website.

Conclusion

248. In sum, on information and belief, Abhyanker, the inventor and patent attorney for the '328 patent, misrepresented and omitted material information with the intent to deceive the USPTO to ensure the issuance of the '328 patent.

249. By reason of this inequitable conduct, the '328 patent and all related patents are unenforceable.

250. Absent a declaration of unenforceability of the '328 patent, Fatdoor is likely to continue to pursue claims of infringement with respect to the '328 patent against Nextdoor and will in this way cause damage to Nextdoor.

251. The '328 patent is further unenforceable as a result of Abhyanker's inequitable conduct committed during the prosecution of related applications, including without limitation U.S. Patent Application Nos. 14/151,844 and 14/144,612, addressed above.

252. Accordingly, Nextdoor seeks a declaration that the '328 patent is unenforceable.

PRAYER FOR RELIEF

WHEREFORE, Nextdoor requests relief against Fatdoor and Abhyanker as follows:

a. For a judgment in favor of Nextdoor denying Abhyanker and Fatdoor all relief requested in the Complaint and dismissing their Complaint with prejudice;

b. For a judgment against Abhyanker and Fatdoor declaring that Nextdoor has not and does not infringe any valid and enforceable claim of the '328 patent;

c. For a judgment against Abhyanker and Fatdoor declaring that one or more claims of the '328 patent are invalid and unenforceable;

d. For a judgment against Abhyanker and Fatdoor declaring that Nextdoor has not and does not infringe any valid and enforceable claim of the '091 patent;

e. For a judgment against Abhyanker and Fatdoor declaring that one or more claims of the '091 patent are invalid and unenforceable;

f. For a judgment against Abhyanker and Fatdoor declaring that Nextdoor has not and does not infringe any valid and enforceable claim of the '545 patent;

g. For a judgment against Abhyanker and Fatdoor declaring that one or more claims

1 of the '545 patent are invalid and unenforceable;

2 h. For a judgment against Abhyanker and Fatdoor declaring that the '328 patent is
3 unenforceable due to inequitable conduct;

4 i. For a judgment against Abhyanker and Fatdoor declaring that the '091 patent is
5 unenforceable due to inequitable conduct;

6 j. For a judgment against Abhyanker and Fatdoor declaring that the '545 patent is
7 unenforceable due to inequitable conduct;

8 k. For a judgment that this is an exceptional case within the meaning of 35 U.S.C.
9 § 285 and awarding Nextdoor its reasonable attorneys' fees;

10 l. For an award of costs to Nextdoor; and

11 m. Such other relief as the Court shall deem just and proper.

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13
14 **DEMAND FOR JURY TRIAL**

15 Nextdoor hereby requests a trial by jury on all issues so triable.

16
17 Dated: August 1, 2014

FENWICK & WEST LLP

18 By: /s/ Michael J. Sacksteder
19 Michael J. Sacksteder

20 Attorneys for Defendant
21 NEXTDOOR.COM, INC.